



D-1077+1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Previous Appeal No.: 2003-1651	)	
	)	
In re Application of:	)	
<b>Jay Paul Drummond, et al.</b>	)	Art Unit 3621
	)	
Application No.: 09/193,787	)	
	)	
Confirmation No.: 2446	)	Patent Examiner
	)	Jalatee Worjloh
Filed: November 17, 1998	)	
	)	
Title: Automated Banking Machine	)	
Apparatus and System	)	

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**SUPPLEMENTAL APPEAL BRIEF OF APPELLANTS  
PURSUANT TO 37 C.F.R. § 41.37**

Sir:

The Appellants hereby respectfully request reinstatement of the appeal. The Appellants hereby submit their Supplemental Appeal Brief pursuant to 37 C.F.R. § 41.37 concerning the above-referenced Application. This Supplemental Appeal Brief is in response to the Office Action dated May 3, 2007.

Adjustment date: 01/02/2008 SSITHIB1  
08/11/2006 BABRAHAI 00000002 090428 09193787  
01 FC:1402 500.00 CR  
01/02/2008 SSITHIB1 00000015 090428 09193787  
01 FC:1402 510.00 DA

(i)

**REAL PARTY IN INTEREST**

The Assignee of all right, title and interest to the above-referenced Application is Diebold, Incorporated, an Ohio corporation.

**(ii) RELATED APPEALS AND INTERFERENCES**

A Board of Patent Appeals and Interferences ("Board") decision (dated October 8, 2003 in Appeal No. 2003-1651) was previously rendered in this application. In said Board decision the Examiner was reversed on all issues. A copy of the decision can be found in the Related Proceedings Appendix.

Other applications (e.g., 09/193,791; 09/193,564; 09/193,662; 09/639,310) having been assigned appeal numbers claim priority to the parent application (09/077,337), which was also appealed. It is believed that these other appeals do not pertain to the subject matter claimed herein. However, it is respectfully requested that the Board make its own determination regarding the pertinence of these other applications. The Board is also requested to check the appeal status of other applications claiming priority to the parent application. Copies of the Board decisions rendered in applications 09/193,791 and 09/193,662 can also be found in the Related Proceedings Appendix.

Appellants, Appellants' legal representative, and assignee believe that there are no additional related appeals or interferences pertaining to this matter.

(iii)

## **STATUS OF CLAIMS**

Claims 1-30 are pending in the Application.

Claims rejected: 1-30

Claims allowed: none

Claims confirmed: none

Claims withdrawn: none

Claims objected to: none

Claims canceled: none

Appellants appeal the rejections of claims 1-30, inclusive. These rejections were the only rejections present in the Office Action (“Action”) dated May 3, 2007.

(iv)

## **STATUS OF AMENDMENTS**

No final rejection is pending. However, claims have been given non-final rejections at least eight different times. Therefore, no amendments to the claims were requested to be admitted after a final rejection.

The following dates and papers are associated with this application:

- |     |          |  |
|-----|----------|--|
| 1.  | 11/05/01 | First Non-final Rejection                    |
| 2.  | 04/16/02 | Second Non-final Rejection                   |
| 3.  | 06/24/02 | 1st Appeal Brief                             |
| 4.  | 09/16/02 | Third Non-final Rejection                    |
| 5.  | 01/17/03 | 2nd Appeal Brief                             |
| 6.  | 10/08/03 | BPAI Decision on Appeal -- Examiner Reversed |
| 7.  | 07/28/04 | Fourth Non-final Rejection                   |
| 8.  | 12/17/04 | 3rd Appeal Brief                             |
| 9.  | 10/18/05 | Fifth Non-final Rejection                    |
| 10. | 02/16/06 | Sixth Non-final Rejection                    |
| 11. | 05/09/06 | Seventh Non-final Rejection                  |
| 12. | 11/06/06 | 4th Appeal Brief                             |
| 13. | 05/03/07 | Eighth Non-final Rejection                   |
| 14. | current  | 5th Appeal Brief                             |

This application was filed on November 17, 1998. Appellants' *original* independent claims still have not been amended. Yet this application has received continued reopening of prosecution, including eight non-final rejections. As factually evidenced by the prosecution history, the Office's propensity to continuously prosecute this application is not in conformance with the Office's normal and expected examining procedures, especially with regard to "compact prosecution." In light of the assigned Group's inability to efficiently examine this application, Appellants again respectfully submit that this application should be transferred to an examining Group that is capable of meeting the stated prosecution goals of the Office. The obfuscation and delay by the examining Group, as evidenced by the record, shows a pattern of arbitrary and capricious action and evidence of willful or wanton misconduct against Appellants.

The repeated imposition of new grounds of rejection by the Office in an effort to deny Appellants judicial review of the refusal to grant their application constitutes an abuse of agency authority. Such actions violate the Administrative Procedures Act, 5 U.S.C. § 701 *et seq.* Such agency action also violates the fundamental legal principle that an administrative agency may not avoid review of its actions by engaging in repetitive activity which does not remain in place long enough to enable judicial review. *Southern Pacific Terminal Co. v. Interstate Commerce Com.*, 219 U.S. 498, 55 L.Ed. 310, 31 S. Cr. 279 (1911).

In light of the Office's propensity to continually reopen prosecution (instead of writing an Examiner's Answer), Appellants reserve all rights and effort to add additional arguments in a Reply Brief (after an Examiner's Answer is actually written). Regardless, as shown in more detail herein, Appellants' claims are allowable over the Office's latest (eighth) grounds of rejection. Thus, Appellants yet again respectfully request reinstatement of their appeal.

**(v) SUMMARY OF CLAIMED SUBJECT MATTER**

*Concise explanations of exemplary forms of the claimed invention:*

For reasons of brevity, claim language may be referred to herein (and in Appellants' arguments) in a shortened version. For example, language such as "at least one" may be simply referred to as "a". Any generalized statement in this Appeal Brief is not to limit any of the mentioned claims in any manner. Please refer to the specific claim for the exact claim language.

With respect to independent claim 1

An exemplary form of the invention is directed to an apparatus. The apparatus comprises an automated banking machine (12) (page 11, lines 13-14; page 13, lines 4-5). The exemplary embodiment of the automated banking machine is an automated teller machine ("ATM").

The automated banking machine (12) includes an output device (e.g., display screen 30) (page 7, line 2; page 13, lines 5-6). The output device can output information, enabling an automated banking machine user to perceive outputs from the output device.

The automated banking machine (12) includes an input device (e.g., keyboard 40 or reader device 38) (page 7, line 3; page 9, lines 4-5; page 13, lines 12-13; and page 29, lines 20-21). The input device can receive inputs, enabling a user of the automated banking machine to provide inputs to the machine.

The automated banking machine (12) includes a transaction function device (36; 42) (page 13, lines 11-18). The transaction function device (36; 42) can selectively carry out a transaction function.

The automated banking machine (12) includes a computer (34). The computer (34) is in operative connection with the output device, the input device, and the transaction function device (page 13, lines 8-12).

The automated banking machine (12) includes software (e.g., 64, 76, 80) executable in the computer (34) (page 14, lines 11-13; page 15, lines 17-18; page 16, lines 9-18). The software includes a browser (76) (page 15, lines 17-18). The browser (76) can process HTML documents having instructions therein (page 16, lines 9-15; page 53, lines 8-9). The transaction function device (36; 42) can carry out (page 20, lines 7-8) the transaction function responsive to the browser (76) processing at least one document including at least one instruction that can cause the computer (34) to cause operation of the transaction function device (36; 42) (page 33, lines 11-13; page 34, lines 18-21; page 9, lines 19-20). Particularly note Figures 2 and 11.

Thus, in an exemplary form of the invention, an ATM (12) can receive HTML documents containing operation instructions, process the instructions using the ATM browser (76), and then (in response to the instructions) cause the ATM computer (34) to operate an ATM transaction function device to carry out an ATM banking transaction function. The HTML document instructions cause the ATM computer (34) to operate the ATM transaction function device.

An example of operation of an exemplary embodiment encompassed by claim 1 will now be described. The ATM is connected to a network such as the Internet and receives at least one HTML document from a remote server computer connected in the network. The received HTML document includes embedded JAVA<sup>®</sup> script or other instructions that are processed by the ATM browser. The ATM computer includes software comprising a JAVA application associated with the operation of a currency note dispenser in the ATM. The ATM computer processed



instructions operate in the JAVA environment to communicate with the JAVA application associated with the currency note dispenser. Thus, the ATM computer operates in response to instructions included in the received HTML document to control a currency note dispenser to dispense currency notes.

With respect to independent claim 8

Another exemplary form of the invention is directed to the Automated Teller Machine (ATM) (12) of claim 8 (page 11, lines 13-14; page 13, lines 4-5). The ATM (12) includes a computer (34) (page 13, lines 8-12) with a browser (76) (page 15, lines 17-18). The ATM (12) also includes a transaction function device (36; 42) (page 13, lines 11-18) in operative connection with the computer (34). The transaction function device can carry out a transaction function responsive to at least one HTML format document that is received by the browser (76) (page 33, lines 11-13; page 34, lines 18-21; page 9, lines 19-20; page 16, lines 9-15; page 53, lines 8-9; page 60, lines 5-8). Particularly note Figures 2 and 11.

With respect to independent claim 9

Another exemplary form of the invention is directed to the method of claim 9. The method comprises operating a browser (76) in at least one computer (34) in connection with an automated banking machine (12). The method further comprises receiving at least one HTML format document with the browser (76) (page 16, lines 9-15). The at least one HTML format document includes at least one transaction instruction (page 9, lines 17-20; page 53, lines 8-9; page 60, lines 5-8). The method also comprises carrying out (page 20, lines 7-8) at least one transaction function with a transaction function device (36; 42) in the automated banking

machine (12) responsive to the at least one HTML format document (page 33, lines 11-13; page 34, lines 18-21; page 9, lines 19-20).

The previous discussions of automated banking machine (12), computer (34), and browser (76) are herein incorporated by reference. Particularly note Figures 2 and 11.

With respect to independent claim 11

Another exemplary form of the invention is directed to the method of claim 11. The method comprises operating a browser (76) in at least one computer (34) in operative connection with an automated banking machine (12). The method further comprises receiving at least one document with the browser (76) (page 16, lines 9-15). The document includes at least one transaction instruction embedded therein (page 9, lines 17-20; page 53, lines 8-9; page 60, lines 5-8). For example, note “embedded” at page 12, line 3; page 16, lines 11 and 13; page 33, line 12; page 39, line 2; and page 45, line 12. The method also comprises carrying out (page 20, lines 7-8) at least one transaction function with a transaction function device (36; 42) in the automated banking machine (12) responsive to the at least one document (page 33, lines 11-13; page 34, lines 18-21; page 9, lines 19-20).

The previous discussions of automated banking machine (12), transaction function device (36; 42), computer (34), and browser (76) are herein incorporated by reference. Particularly note Figures 2 and 11.

With respect to independent claim 12

Another exemplary form of the invention is directed to the Automated Teller Machine (ATM) (12) of claim 12 (page 11, lines 13-14; page 13, lines 4-5). The ATM (12) can operate (36; 42) to conduct (page 20, lines 7-8) at least one financial transaction responsive to at least

one mark-up language document (page 33, lines 11-13; page 34, lines 18-21; page 9, lines 19-20). Particularly note Figures 2 and 11.

With respect to independent claim 13

Another exemplary form of the invention is directed to the automated banking machine (12) of claim 13. The automated banking machine (12) comprises a computer (34) and at least one transaction function device (36; 42) in the banking machine (12). The at least one transaction function device (36; 42) is adapted to carry out at least a portion of a banking transaction (page 33, lines 11-13). The computer is adapted to cause at least one banking transaction to be carried out through operation of the at least one transaction function device responsive to at least one mark up language document (page 33, lines 11-13; page 34, lines 18-21; page 9, lines 19-20). Particularly note Figures 2 and 11.

With respect to independent claim 16

Another exemplary form of the invention is directed to the method of claim 16. The method comprises providing an automated banking machine (12) including at least one transaction function device (36; 42). The automated banking machine is in operative connection with at least one computer (34). The method further comprises processing (page 16, lines 9-15; page 53, lines 8-9) at least one mark up language document with the computer (34, 76) (page 15, lines 17-18). The method also comprises carrying out (page 20, lines 7-8) at least a portion of a banking transaction with the transaction function device (36; 42) responsive to processing the at least one mark up language document with the computer (34) (page 33, lines 11-13; page 34, lines 18-21; page 9, lines 19-20). Particularly note Figures 2 and 11.

**(vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The questions presented in this appeal are presented below.

The rejection based on 35 U.S.C. § 112, first paragraph:

- 1). Whether claim 12 is unpatentable pursuant to 35 U.S.C. § 112, first paragraph, as being a single means claim.

The rejection based on 35 U.S.C. § 103(a):

- 2). Whether claim 12 is unpatentable pursuant to 35 U.S.C. § 103(a) as obvious over Morioka, et al. (US 5,650,605) (hereinafter "Morioka") in view of Wagner (US 5,742,845).

The provisional rejections based on nonstatutory obviousness-type double patenting:

- 3). Whether claims 1, 8, 9, 11, 13, 14, 16, 25, and 28 are provisionally unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209.
- 4). Whether claims 1, 8, 9, 11, 13, and 16 are provisionally unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 12 of application 09/233,249.
- 5). Whether claims 2-5 and 7 are provisionally unpatentable on the ground of nonstatutory obviousness-type double patenting over the corresponding claims 2-5 and 7 of application 10/980,209.

- 6). Whether claim 6 is provisionally unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 4 of application 10/980,209.
- 7). Whether claims 15 and 17 are provisionally unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209 in view of Watanabe (US 4,542,287).
- 8). Whether claim 15 is provisionally unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 12 of application 09/233,249 in view of Watanabe (US 4,542,287).
- 9). Whether claims 18 and 19 are is provisionally unpatentable on the ground of nonstatutory obviousness-type double patenting over claims 1 and 3 of application 10/980,209 in view of Wagner (US 5,742,845).
- 10). Whether claim 20 is provisionally unpatentable on the ground of nonstatutory obviousness-type double patenting over claims 1 and 6 of application 10/980,209 in view of Wagner (US 5,742,845).
- 11). Whether claim 21 is provisionally unpatentable on the ground of nonstatutory obviousness-type double patenting over claims 1 and 4 of application 10/980,209 in view of Sime (US 5,386,104).
- 12). Whether claims 10, 22, 23, and 26 are provisionally unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209 in view of Wagner (US 5,742,845).

- 13). Whether claims 24 and 30 are provisionally unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209 in view of Okamoto (US 5,064,999).
- 14). Whether claim 27 is provisionally unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209 in view of Merriam Webster Collegiate Edition, 1990.
- 15). Whether claim 29 is provisionally unpatentable on the ground of nonstatutory obviousness-type double patenting over claims 1 and 2 of application 10/980,209 in view of Watanabe (US 4,542,287).

For convenience, the above provisional rejections have also been outlined as below:

<u>Claim Rejected</u>	<u>on</u>	<u>Application's</u>	<u>Claim</u>	<u>and</u>	<u>Secondary Reference</u>
1		10/980,209	1		none
1		09/233,249	12		none
2		10/980,209	2		none
3		10/980,209	3		none
4		10/980,209	4		none
5		10/980,209	5		none
6		10/980,209	4		none
7		10/980,209	7		none
8		10/980,209	1		none
8		09/233,249	12		none

9	10/980,209	1	none
9	09/233,249	12	none
10	10/980,209	1	Wagner (US 5,742,845)
11	10/980,209	1	none
11	09/233,249	12	none
13	10/980,209	1	none
13	09/233,249	12	none
14	10/980,209	1	none
15	10/980,209	1	Watanabe (US 4,542,287)
15	09/233,249	12	Watanabe
16	10/980,209	1	none
16	09/233,249	12	none
17	10/980,209	1	Watanabe
18	10/980,209	1 and 3	Wagner
19	10/980,209	1 and 3	Wagner
20	10/980,209	1 and 6	Wagner
21	10/980,209	1 and 4	Sime (US 5,386,104).
22	10/980,209	1	Wagner
23	10/980,209	1	Wagner
24	10/980,209	1	Okamoto (US 5,064,999)
25	10/980,209	1	none
26	10/980,209	1	Wagner

27	10/980,209	1	Merriam Webster Dictionary
28	10/980,209	1	none
29	10/980,209	1 and 2	Watanabe
30	10/980,209	1	Okamoto

Claim 12 is not subject to any provisional obviousness-type double patenting rejection.



(vii)

## ARGUMENT

### **The Rejection Under 35 U.S.C. § 112, First Paragraph**

Claim 12 has been rejected under 35 U.S.C. § 112, first paragraph, as allegedly being a “single means claim.” The Appellants respectfully disagree. Appellants’ application meets the requirements of 35 U.S.C. § 112, first paragraph.

#### **The First Paragraph of 35 U.S.C. § 112:**

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention."

#### **Claim 12 recites:**

An Automated Teller Machine (ATM) that operates to conduct at least one financial transaction responsive to at least one mark-up language document.

Appellants respectfully submit that the Board already fully considered claim 12 in the decision rendered October 8, 2003 (in Appeal No. 2003-1651). The decision reversed the rejection of claim 12. Nowhere in the decision did the Board imply that claim 12 was a single means claim. Nor is it. Nowhere in the decision did the Board imply that Appellants’ application did not meet the requirements of 35 U.S.C. § 112, first paragraph.

The Office's reliance on *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) is misguided. The issue in *In re Hyatt* specifically involved a claim having a means-plus-function format. Claim 12 does not include a means-plus-function format. Claim 12 does not use “means” or “means for.” Claim 12 does not invoke 35 U.S.C. § 112, sixth paragraph. Thus, claim 12 cannot be a “single means claim”, as the Office alleges.

Furthermore, there is nothing wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. Appellants' functional limitation is used in association with an element to define a particular capability or purpose that is served by the recited element. The recited functional limitation serves to precisely define present structural attributes of the claimed invention. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976). MPEP § 2173.05(g).

The Action's comment (on page 6) that “there are not [sic] distinct functions that make the device of claim 12 an ATM” is without merit. Nor is the comment a 35 U.S.C. § 112, first paragraph, issue. The Action's comment is analogous to saying that “there are no distinct functions that make an Appeal Brief an Appeal Brief.” Applicants are not required to recite apparatus structure at the atomic level.

The Office itself recognizes an “ATM” via its own well established patent classification system(e.g., class/subclass 705/43). The Office can't legally define an ATM for US patent purposes, then deny Appellants' fair use of that definition.

Claim 12 also finds support in Appellants' disclosure. Claim 12 is an originally examined claim. Thus, it is unreasonable for the Office to allege that claim 12 lacks support. It is respectfully submitted that the 35 U.S.C. § 112, first paragraph rejection is improper and should be reversed.

Claim 12 meets the enablement requirement of 35 U.S.C. § 112, first paragraph. The broadest scope of claim 12 reads on subject matter to which Appellants' specification is enabling. The claim is not a single means claim. The claim does not read on every conceivable structure for achieving the result. The claim does not read on "everything" that operates to conduct at least one financial transaction responsive to at least one mark-up language document. Rather, claim 12 is limited to an ATM structure, to which Appellants' enabling specification contains a teaching of the manner and process of making and using the invention in terms that correspond in scope to those used in the claim. One skilled in the art would recognize an "ATM". Again, even the Office's own patent classification system recognizes an "ATM" (e.g., class/subclass 705/43).

Functional language does not solely define the ATM. Rather the ATM is further defined by its functional capabilities. There is nothing wrong with further defining an invention in functional terms. Functional language does not, in and of itself, render a claim improper. A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976). MPEP § 2173.05(g).

Nor does claim 12 purport to cover all ATMs. Rather the claim only covers an ATM having a structure that permits the ATM, in response to a mark-up language document, to operate

to conduct a financial transaction. One skilled in the art would recognize that not all ATMs can operate in response to a mark-up language document. The invention is to an ATM that can, and this is the invention sought in claim 12. The claim does not read on all ATMs. This is further evidence that the claim is not a single means claim.

In order for claim 12 to have been a single means claim, and to have read on structure other than a mark-up language document-responsive ATM, the claim would have had to recite: "A means that operates to conduct at least one financial transaction responsive to at least one mark-up language document." However, this is not what is recited. The rejection is improper and should be reversed.

The Office Action dated February 16, 2006 (on page 2) mentioned *In re Hyatt* and the additional cases of *Fiers v. Sugano*, 25 USPQ2d 1601, Nos. 92-1170-1171 (Fed. Cir. 1993); *Ex parte Maizel*, 27 USPQ2d 1662, No. 91-2301 (BPAI 1992); and *Ex parte Kung*, 17 USPQ2d 1545, No. 88-0962 (BPAI 1989). In response thereto, Appellants hereafter discuss in detail why these mentioned cases actually point to claim 12 as not being a single means claim.

#### *In re Hyatt*

Appellants respectfully submit that this case is non analogous. In this case the Court indicated that the claimed invention was defined by what followed the word "comprising." This indication limited the claim to a single "*means for* incrementally generating . . ." The Court indicated that a single means claim covers every conceivable means for achieving the stated result, while the specification discloses at most only those means known to the inventor. Thus, the claim read on subject matter to which the specification was not enabling.

Appellants respectfully submit that claim 12 is not a single means claim. Claim 12 is directed to "An Automated Teller Machine (ATM) that operates to conduct at least one financial transaction responsive to at least one mark-up language document." Nor does the claim equate to a single means claim. Claim 12 does not use "means" or "means for" or "for." As set forth in the specification, the ATM requires specific ATM structure, it does not constitute every conceivable means (structure). The specific structure enables a particular capability or purpose to be served. Likewise, the functional limitation serves to precisely define present structural attributes of the ATM.

The Office confuses the basis of the decision in this case. The decision in Hyatt was based on use of language directed to unknown "*means* for incrementally generating . . ." The decision was not based on language directed to "A Fourier transform *processor* that generates incremental output signals in response to incremental input signals", as apparently interpreted by the Office. The disclosed structure of a processor differs from a non disclosed and unknown "means." Likewise, in the present situation one skilled in the art would have recognized that a disclosed ATM differs from an unknown single means.

The Court also indicted that the claim in Hyatt was drawn to a single element. Conversely, an ATM inherently implies more than one element. An ATM that operates to conduct at least one financial transaction responsive to at least one mark-up language document would also comprise more than one element. Additionally, unlike the structure in the claim in Hyatt, the ATM of claim 12 is involved in the function.

Fiers v. Sugano

Appellants respectfully submit that this case is non analogous. This case relates to award of invention priority in an interference. The recited claim at issue was directed to a product, a DNA sequence. The Court held that a specification that did not describe the structure of the recited product (but instead may have described a method of producing the product) did not satisfy the written description requirement of 35 U.S.C. § 112, first paragraph.

From the Fiers case the Office quotes "Claiming all DNA's that achieve a result without defining what means will do so is not in compliance with the description requirement; it is an attempt to preempt the future before it has arrived." However, the quote is taken out of context. The quoted "defining what means will do so" appears to refer to defining written description in the specification, not in the claim as apparently relied upon by the Office. The Court concluded that Sugano's disclosure both met the written description requirement and was enabling.

Appellants' specification conveys with clarity to one skilled in the art, the required structure of the recited ATM in claim 12. Thus, the written description requirement of 35 U.S.C. § 112 is met. Furthermore, the enablement requirement of 35 U.S.C. § 112 is satisfied because Appellants' application contains description that enables one skilled in the art to make and use the claimed invention. It follows that the 35 U.S.C. § 112, first paragraph, rejection is improper and should be reversed.

Ex parte Maizel

Appellants respectfully submit that this case is non analogous. The 35 U.S.C. § 112, first paragraph, enablement issue noted by the Office in the Maizel case involved the specific claim language "or a biologically functional equivalent thereof." The Board held that the claim

language broadened the claim to cover any structure that could achieve the stated biological function while the specification only disclosed using a specific DNA segment. For example, a "cell" could be used instead of "DNA." However, description of using of a cell did not find support in the specification. Thus, the disclosure was deemed not commensurate in scope with the broader claim. The Board indicated that the claim might be equated to a single means claim.

The language of Appellants' claim 12 does not broaden the claim to cover any ATM structure, but is limited to the structure of a mark-up language document-responsive ATM. Claim 12 does not read on every structure that can conduct at least one financial transaction responsive to at least one mark-up language document, as the Office apparently alleges.

*Ex parte Kung*

Appellants respectfully submit that this case is also non analogous. The 35 U.S.C. § 112, first paragraph, enablement issue noted by the Office in the Kung case involved recited antibodies whose scope was not restricted to the specific class of antibodies formed by the process disclosed. Experiments showed that the disclosed process only provided guidance for forming a few antibodies, whereas the broad claims permitted forming more antibodies than disclosed. It was also admitted that the antibodies falling within the scope of the Kung claims could be different from those described. The Kung specification was not commensurately enabling. Thus, the Board indicated that the claim might be tantamount to a single means claim.

The disclosure was held non enabling because the Kung claim scope was not restricted to a specific class of structure (antibodies). However, the scope of the recited structure in Appellants' claim 12 is restricted to a specific class of structure (ATM) to which the process of

making and using is disclosed. The reasoning stated by the Board in Kung further shows that Appellants' claim 12 is not a single means claim.

Appellants' claim 12 does not have any "means plus function" elements. Rather, the claim recites an ATM (a specific structure) that operates in a specific manner as claimed. The machine as specifically claimed in claim 12 is fully supported by the teachings in the specification.

It is respectfully submitted that the rejection of claim 12 should be reversed.



## **The Rejection Under 35 U.S.C. § 103(a)**

### **The Applicable Legal Standards**

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features and relationships of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

Even if all of the features recited in a claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is an identified valid reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. *KSR International Co. v. Teleflex Inc.*, U.S., No. 04-1350, April 30, 2007.

A determination of patentability must be based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

### The Morioka Reference

Morioka is directed to a display device (1) for an ATM. The display device (1) is directed to physically disabled users, particularly those who may have difficulty in selecting and operating small numeric keys (e.g., col. 1, lines 59-67; col. 11, lines 21-24). Such difficulty can result in erroneous key inputs.

The input device (2) includes a transparent switch (10) that is arranged over the display surface of the display device (1). Displayed on the screen of the display device (1) are two large buttons, a "YES" button (B0) and a "NO" button (B1). When one of the buttons on the screen is touched, the switch (10) functions to receive user input as either "YES" or "NO".

The arrangement allows a user to input information corresponding to displayed content merely by touching the display screen. The touch screen display allows a user to perform an entire transaction merely by selectively operating only the two "YES" and "NO" buttons (e.g., col. 21, lines 33-42). The two buttons "YES" and "NO" eliminate the need for other buttons.

### The Wagner Reference

Wagner teaches that the Internet suffers from a number of limitations, such as lack of security, which precludes its use in financial transactions (col. 3, lines 40-44). Wagner is directed to a system that permits the consumer to initiate a transaction and order from a merchant, and then switch to a conventional secure link for the confidential financial aspects of the transaction (col.6, lines 23-27). Wagner's invention seeks to use the information gathering advantage of the Internet while maintaining the security advantage of conventional secured communication links for handling the financial transaction (col.7, lines 15-25).

Wagner specifically teaches that an I/O device may be used to communicate with a plurality of Web servers to "shop" for a best price and other non-confidential information, but that conventional secure communication and data security devices are utilized to consummate the financial elements of the transaction (col. 18, lines 56-64). Wagner's PAYMENT attribute is a directive to use a private payment network for secure communication of the financial transaction data (col. 11, lines 58-61). This directive activates a conventional financial transaction application which communicates with a transaction system over a dedicated data line or PSTN in a known protocol, such as VISA (col. 11, lines 61-65). Again, for communication of financial transaction data, the client program is suspended and control is transferred to a conventional secure bank processing application (col. 18, lines 37-49).

Wagner is non-enabling

Wagner's disclosure does not meet the requirements of 35 U.S.C. § 112. Thus, Wagner (U.S. Patent No. 5,742,845) is non-enabling. Wagner's lack of enablement renders it inoperative as a valid prior art reference.

Wagner's use of the term "non-standard I/O device" is vague and indefinite, and renders the disclosure non-enabling. Wagner provides examples of non-standard I/O devices, such as smart card reader (32), PIN pad (34), magnetic card swipe reader (36), and printer (38). To anyone having skill in the computer arts "I/O" means "input/output." However, none of these devices is an *input/output* device. A smart card reader, PIN pad, and magnetic card swipe reader are input-only devices. A printer is an output-only device. Thus, Wagner's use of "I/O device" is not in compliance with known accepted standards. Nor did Wagner specifically redefine the accepted meaning of an "I/O device." It follows that one having ordinary skill in the art would

not be able to ascertain the scope of Wagner's disclosed invention. As a result, Wagner's disclosure is non-enabling.

Again, the term "*non-standard I/O device*" is vague and indefinite, and not specifically defined to a sufficient degree to overcome the lack of any accepted meaning. Nor is the term one that has an accepted meaning that is well known in the art. The scope of the term appears to improperly cover every conceivable structure that is not a "standard I/O device." Such examples include paper and a pencil. The undue breath of the term renders the disclosure non enabling. One having ordinary skill in the art would be unable to carry out Wagner's disclosed invention, even with undue experimentation. The Wagner patent does not teach sufficient information to put the public in possession of the invention and to enable those skilled in the art to make and use the invention. There is nothing in the patent that informs the public how to use the invention and how to avoid infringement.

In conclusion, the disclosure of Wagner is non-enabling. The applied Wagner reference does not constitute prior art to Appellant's invention.

Wagner's teaching is limited to the level of ordinary skill in 1995

The present invention is entitled to (and claims benefit of) the November 27, 1996 filing date of provisional application 60/031,956. Wagner was filed June 22, 1995 (and Morioka's filing date is even earlier). It follows that Wagner's teaching with regard to technology is limited to the early 1995 time period.

Appellants respectfully submit that the Office failed to correctly ascertain the level of one having ordinary skill in the art at the time of Wagner's filing. The Office did not reach a conclusion based on facts gleaned only from the applied prior art. Instead, the Office attempts to

incorrectly apply today's level of one having ordinary skill in the art to the teaching of Wagner (and Morioka). The Office's attempted usage of hindsight to breathe new matter into Wagner's antiquated teaching is legally impermissible. The Office cannot add to Wagner what Wagner does not teach.

**Claim 12 is not obvious over Morioka in view of Wagner**

The Office admits (on Action page 25) that Morioka does not teach or suggest that a "financial transaction is responsive to at least one mark-up language document".

Wagner is silent regarding the components and operation of the ATM mentioned in his Background section. Nevertheless, Wagner does not teach or suggest an ATM that operates to conduct at least one financial transaction responsive to at least one mark-up language document. Wagner does not teach the recited ATM/document/transaction relationship. Where does Wagner teach or suggest an ATM that operates to conduct a financial transaction responsive to a mark-up language document? Where does Wagner teach or suggest, in response to a mark-up language document, operating an ATM to conduct a financial transaction? Wagner doesn't. Rather, as previously discussed, Wagner uses a conventional, secure (non-Internet), communications link (e.g., VISA protocol) when conducting a financial transaction. The Office has not established a *prima facie* case of obviousness. It would not have been obvious to one of ordinary skill in the art to have modified Morioka with the teaching of Wagner in the manner alleged by the Office to have produced the recited invention of claim 12.

The rejection (on Action page 26) states that Wagner teaches "that a financial transaction is responsive to at least one mark-up language document" and that it would have been obvious "to modify the financial transaction of Morioka et al. to be responsive to a mark-up language

document as taught by Wagner". However, Wagner does not teach or suggest conducting a financial transaction responsive to a mark-up language document. Nor does Wagner teach or suggest, in response to a mark-up language document, operating an ATM to conduct a financial transaction. Rather, as previously discussed, Wagner teaches away from conducting a financial transaction responsive to a mark-up language document. In Wagner a financial transaction is conducted with a conventional secured (non-Internet) communications link (e.g., VISA protocol), which does not involve a mark-up language document. That is, Wagner uses a conventional secure line for carrying out a financial transaction, not a mark-up language document via the Internet as the Office alleges.

Wagner does not teach or suggest conducting a financial transaction in response to a mark-up language document. Nor does Wagner teach or suggest operating an ATM to conduct a financial transaction in response to a mark-up language document. It follows that Wagner cannot alleviate the admitted deficiencies of Morioka.

Further arguments that rebut the features attributed to Wagner can be found in Appellants' prior Appeal Brief dated December 17, 2004, which for reasons of brevity is herein incorporated by reference.

## **The Provisional Nonstatutory Obviousness-Type Double Patenting Rejections**

### **The Applicable Legal Standards**

An obviousness-type double patenting rejection of an application claim requires that the claim *not* be patentably distinct from the subject matter claimed in a commonly owned patent when the issuance of a second patent (with the claim) would provide unjustified extension of the right to exclude granted by the patent. Where restriction between the claims at issue can be made, obviousness-type double patenting cannot be held. When considering the invention in a claim relied upon for rejection, the disclosure of its application may not be used as prior art. The analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. § 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991). MPEP § 804 and 806.

A nonstatutory obviousness-type double patenting rejection is based on judicially created doctrine. Making an applicant aware of a potential nonstatutory obviousness-type double patenting problem can be carried out via a "provisional" rejection on the ground of nonstatutory obviousness-type double patenting (MPEP § 804(IB)). This type of rejection is "provisional" because a conflicting claim has not yet been patented to justify a legal double patenting rejection.

The conclusion of obviousness-type double patenting is made in light of the factual determination set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). An obviousness-type double patenting rejection should make clear:

- (A) The differences between the inventions defined by the conflicting claims -- a claim in the patent compared to a claim at issue in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim in the patent.

There must be an identified valid reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. *KSR International Co. v. Teleflex Inc.*, supra. *In re Zurko*, supra. *In re Lee*, supra.

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

**Decisions on the provisional obviousness-type double patenting rejections are not required**

The nonstatutory obviousness-type double patenting rejections are merely provisional. They are "provisional" because none of the allegedly conflicting claims has yet been patented to justify a legal double patenting rejection. That is, there is no legal double patenting rejection pending. As a result, Appellants respectfully submit that the Board need not decide the provisional rejections, but only whether claim 12 is unpatentable with regard to the other issues.

Appellants respectfully submit that USPTO examining procedures dictate that if provisional nonstatutory obviousness-type double patenting rejections are the only rejections remaining in an earlier-filed or base application, then the Office must withdraw these rejections and permit that application to issue as a patent without need of a terminal disclaimer. MPEP § 804(IB). Furthermore, it is well known that in comparison to fixed claims in a patent, claims in pending applications are relatively fluid as they can easily change. The facts of record show that



this application was either (1) filed earlier than all of the relied upon other applications (i.e., 10/980,209 and 09/233,249) in the provisional rejections, or (2) is the base application.

Claim 12 was not provisionally rejected on nonstatutory obviousness-type double patenting. A Board decision on claim 12 will result in either allowance or cancellation of said claim. If the rejection of claim 12 is sustained by the Board, then Appellants authorize the Examiner to cancel claim 12 by Examiner's amendment to allow the application. With claim 12 no longer an issue, the provisional nonstatutory obviousness-type double patenting rejections would then be the only rejections remaining. As a result, in accordance with MPEP § 804(IB) these provisional rejections would have to be withdrawn by the Office because the instant application is the earlier-filed or base application.

Even if the pending provisional nonstatutory obviousness-type double patenting rejections were somehow valid (which they aren't), they should be held by the Board as moot for purposes of this appeal. Appellants respectfully request that the Board, following its decision on claim 12, order the Office to withdraw the provisional nonstatutory obviousness-type double patenting rejections and issue this application as a patent.

**The source on which the rejections are based is not a valid source**

The Office can only rely on an application's claimed subject matter when presenting an obviousness-type double patenting rejection, not the application's entire disclosure. However, the Action provides evidence that the entire disclosure of applications was relied upon as the basis for the rejections. For example, each of the provisional rejections states that the conflicting claims are not patentably distinct from each other because either "Application No. 10/980,209

discloses . . ." or "Application No. 09/233,249 discloses . . .". That is, each rejection relies on (and uses) the *entire* disclosure of an application. Nowhere is there evidence that the rejections rely on claim language alone, as is required.

The fact that some of the relied upon other application claims are not even pending, is further evidence of the provisional rejections improperly relying on an application's entire disclosure. For example, as discussed in more detail later, claims 2-7 haven't been pending in application 10/980,209 for many years. However, the subject matter in the disclosure of application 10/980,209 that had provided support to these (now canceled) claims 2-7 is what is relied upon in the provisional rejections.

Thus, the source (i.e., an application's entire disclosure) on which the rejections are based is not a valid source. For this reason alone the rejections are not legally valid.

Also, Appellants made the Office aware in the previous Appeal Brief dated November 6, 2006 that claims 2-7 were not pending in application 10/980,209. That the Office continues to impose a rejection based on claims that don't exist is troubling. It also points to the Office following a predetermined plan to purposely reopen prosecution (to avoid judicial review) regardless of what Appellants submit in a response.

**The Office has not established a *prima facie* case of obviousness**

There is no evidence of record that the Office's conclusion of obviousness-type double patenting was made in light of the factual determination set forth in *Graham v. John Deere Co.*, as is required for an obviousness determination. For example, the rejection does not make clear either (A) the *differences* between the inventions defined by the conflicting claims or (B) the

*reasons* why a person of ordinary skill in the art would conclude that the recited invention defined in the claim at issue in the present application would have been an obvious variation of an invention defined in a claim in another application.

The Action is silent as to the "differences" between the claims at issue in this application and the claims in other applications. That is, the Action fails to point out what is *not* taught or suggested. The Action is also silent as to reasons or conclusion for alleging obvious variation. Because the Action has not properly conducted a *Graham v. John Deere Co.* analysis, it follows that no *prima facie* case of obviousness has been presented. That is, the Action procedurally fails to establish a *prima facie* case of obviousness. Hence, the Office has not met the basic criteria for establishing a *prima facie* case of obviousness-type double patenting.

Nor has the Action established that the "differences" between the claims at issue in the present application would have been an obvious variation of claims in another application. Where is this alleged evidence that is relied upon? Where is there any evidence of suggestion or desirability to modify a relied upon claim to produce the subject matter of a rejected claim?

Any teaching or suggestion relied upon must be clearly and particularly identified in order to support a legally valid rejection on the basis of obviousness. The Office has not met this burden. It follows that the Action does not factually support any *prima facie* conclusion of obviousness.

If the Office does not produce a *prima facie* case of obviousness (which is the current situation), then the Appellants are under no obligation to submit evidence of nonobviousness (MPEP § 2142).

**The nonstatutory obviousness-type double patenting rejections are improper**

The absence of the required explanation (MPEP § 804(IIB1)) of the “differences” between Appellants' claimed invention and other applied claims is evidence that the Action has not presented a valid nonstatutory obviousness-type double patenting rejection. A further indication that the Action does not present a valid nonstatutory obviousness-type double patenting rejection is the Action’s silence regarding specific reasons why one of ordinary skill in the art would have concluded Appellants' claimed invention to be an obvious variation of the other relied upon (applied) inventions.

At best, the provisional obviousness-type double patenting rejections are based on claims having some common subject matter. However, the overlapping of inventions due to claiming some common subject matter is *not* the requisite legal criteria for establishing a valid nonstatutory obviousness-type double patenting rejection. For instance, the Office’s own class/subclass classification system is based on patents claiming some common subject matter.

Also, "domination" and "double patenting" should not be confused (which may be the current situation), as they are two separate issues. An application “dominates” another when it has a broad claim which fully encompasses another’s more narrow claim (MPEP § 804(II)). Domination by itself cannot support a nonstatutory obviousness-type double patenting rejection.

The Office has not established a legally valid basis for the allegations of obviousness-type double patenting. The provisional rejections are based on mere allegations, not legally valid evidence of record. An obviousness-type double patenting rejection requires that the claimed subject matter in the relied upon different application *not* be patentably distinct from the claim being rejected. The Action lacks a showing that the instant claims are not patentably distinct

from the claimed subject matter relied upon for rejection. Conversely, if it can be shown that the claims at issue are patentably distinct from each other, then the rejections are without merit.

Whether claims are patentably distinct can be determined based upon whether the claims could be restricted from each other (as if present in the same application). It follows that if the claims at issue could be restricted from each other (if they were present in the same application), then the rejections are without merit.

The claims at issue are patentably distinct from each other

Appellants respectfully submit that the claims at issue are patentably distinct from each other, as discussed in more detail later. Thus, Appellants respectfully submit that the provisional obviousness-type double patenting rejections are improper and should be reversed.

It should be understood that Appellants' arguments below may not necessarily contain *all* of the patentably distinct features between the claims. However, the arguments do show satisfactory evidence that proves the provisional obviousness-type double patenting rejections presented are improper.

It should also be understood that for reasons of brevity, as previously mentioned, claim language may be referred to in Appellants' arguments in a shortened version. For example, language such as "at least one" may be simply referred to as "a". Any generalized statement in this Appeal Brief is not to limit any of the mentioned claims in any manner. Please refer to the specific claim for the exact claim language. For ease of understanding, the individual independent claims will be addressed first herein.

### **The Independent Claims**

The pending independent claims are either not an obvious variation of an applied application claim or patentably distinct therefrom. Thus, the rejections are not legally valid.

#### **Independent Claim 1**

Pending claim 1 is directed to an apparatus. Pending claim 1 recites an automated banking machine that includes a computer in operative connection with an output device, an input device, and a transaction function device. The automated banking machine further includes software executable in the computer. The software includes a browser that is operative to process HTML documents including instructions therein. The transaction function device is operative to carry out a transaction function responsive to the browser processing at least one instruction (of at least one document) that causes the computer to cause operation of the transaction function device.

#### **Claim 1 is not an obvious variation of claim 1 in application 10/980,209**

Claim 1 of application 10/980,209 is as set forth in the preliminary amendment filed November 2, 2004. For the benefit of the Board, a copy of said claim is provided in the Evidence Appendix.

The application's claim 1 does not teach or suggest the features and relationships recited in pending claim 1. Where does the application's claim 1 teach or suggest the recited browser of pending claim 1? Where does the application's claim 1 teach or suggest the recited transaction function device of pending claim 1? Where does the application's claim 1 teach or suggest the recited relationship between the browser and the transaction function device, wherein the transaction function device can carry out its transaction function responsive to the browser's

document processing? It doesn't. The Office has not established that pending claim 1 is an obvious variation of claim 1 in application 10/980,209.

The Office appears to be reading into the application's claim 1 more than what it specifically teaches or suggests. Again, the Office can only rely on the subject matter recited in claim 1 of application 10/980,209, not the application's entire disclosure (which appears to be the situation).

Appellants have shown that claim 1 in application 10/980,209 alone does not teach or suggest all of the features and relationships that are specifically recited in pending claim 1. No secondary teaching or suggestion has been relied upon in the rejection of pending claim 1. Thus, the rejection is improperly based on mere assertions and not concrete evidence of record. *In re Zurko*, supra. *In re Lee*, supra. It follows that a *prima facie* case of obviousness has not been established.

Claim 1 in application 10/980,209 is devoid of any teaching or suggestion to produce the recited invention of pending claim 1. Therefore, Appellants respectfully submit that pending claim 1 cannot be an obvious variation of claim 1 in application 10/980,209. Thus, the provisional rejection of claim 1 is not legally valid and should be reversed.

Claim 1 is patentably distinct from claim 1 in application 10/980,209

In order to establish a legally valid provisional nonstatutory obviousness-type double patenting rejection, the claims at issue must be both related and not patentably distinct from each other. However, as shown in detail below, the claims are patentably distinct from each other.

The Office has not established that the inventions (of pending claim 1 and claim 1 in application 10/980,209) are related. Inventions are related if they are connected in at least one of

design (e.g., structure), operation (e.g., method of use), or effect. Examples of related inventions include combination and subcombination; process and apparatus for its practice; and process and product made (MPEP § 802.01). Where has the Office established that the inventions are even related? It hasn't. Thus, the Office has not established a basis for the nonstatutory obviousness-type double patenting rejection.

Even if the inventions (of pending claim 1 and claim 1 in application 10/980,209) were somehow shown to be related by the Office (which hasn't been established), the Office still has not shown that the inventions are not patentably distinct from each other. Conversely, the inventions, if somehow shown to be related, would still be patentably distinct from each other.

The application's claim 1 is directed to a *method*, not an *apparatus* (like pending claim 1). Even if the inventions were related (for sake of argument), they would be related as process and apparatus for its practice. Such inventions are *patentably distinct* if it can be shown (MPEP § 806.05(e)) that either:

- (1) the process as claimed can be practiced by another materially different apparatus or by hand; or
- (2) the apparatus as claimed can be used to practice another materially different process.

In such a relationship scenario, the process of application's claim 1 could be practiced by an apparatus materially different from the apparatus of pending claim 1. For example, the process of application's claim 1 can be used without an apparatus (like pending claim 1) that requires a browser. That is, the process can be practiced by an apparatus without a browser. The process of application's claim 1 is not limited to practice with the features of the apparatus of



pending claim 1. Likewise, the process of application's claim 1 can be used with an apparatus that does not require a transaction function device that can carry out its transaction function responsive to a browser's processing. These are patentably distinct features.

Additionally, the apparatus (of pending claim 1) as claimed can be used to practice another materially different process from that in the application's claim 1. For example, the pending claim 1 apparatus can be used to practice a process (unlike application's claim 1) that does not require operating at least one computer to send at least one message from the machine. The apparatus (of pending claim 1) is not limited to use in the process of application's claim 1. Also, the pending claim 1 apparatus can be used to practice a process (unlike application's claim 1) that does not require operating at least one computer to send the at least one first message responsive to at least one condition of the machine. These are also patentably distinct features.

A legally valid obviousness-type double patenting rejection requires that the pending claim 1 and the application's claim 1 cannot be patentably distinct from each other. However, Appellants have shown otherwise. Appellants have shown that these claims, even if somehow shown to be related, would still be patentably distinct from each other. Thus, the provisional nonstatutory obviousness-type double patenting rejection of pending claim 1 (based on claim 1 of application 10/980,209) is not legally valid.

Claim 1 is not an obvious variation of claim 12 in application 09/233,249

Claim 12 of application 09/233,249 is as set forth in the original application filing on January 19, 1999. For the benefit of the Board, a copy of said claim 12 is provided in the Evidence Appendix.

The application's claim 12 does not teach or suggest the features and relationships recited in pending claim 1. Where does the application's claim 12 specifically teach or suggest the recited browser of pending claim 1? Where does the application's claim 12 teach or suggest the recited transaction function device of pending claim 1? Where does the application's claim 12 teach or suggest the recited relationship between the browser and the transaction function device, wherein the transaction function device can carry out its transaction function responsive to the browser's document processing? It doesn't.

Pending claim 1 recites that the transaction function device is operative to carry out the transaction function *responsive to the browser processing* at least one document including at least one instruction. Dissimilarly, the application's claim 12 recites that the computer is operative to cause the transaction function device to carry out the transaction function *responsive to input* to an input device (which can receive input from machine users). That is, generally speaking, a transaction function device carrying out a transaction function is "responsive to the browser processing" in pending claim 1, but is differently "responsive to at least one first input to the first input device" in the application's claim 12. The Office has not established that pending claim 1 is an obvious variation of claim 12 in application 09/233,249.

The Office appears to be reading into the application's claim 12 more than what it specifically teaches or suggests. The Office can only rely on the claimed subject matter of claim 12 in application 09/233,249, not the application's entire disclosure (which appears to be the situation).

Appellants have shown that claim 12 in application 09/233,249 alone does not teach or suggest all of the features and relationships that are specifically recited in pending claim 1. No

secondary teaching or suggestion has been relied upon in the rejection of pending claim 1. Thus, the rejection is improperly based on mere assertions and not concrete evidence of record. *In re Zurko*, supra. *In re Lee*, supra. It follows that a *prima facie* case of obviousness has not been established.

Claim 12 in application 09/233,249 is devoid of any teaching or suggestion to produce the recited invention of pending claim 1. Therefore, Appellants respectfully submit that pending claim 1 cannot be an obvious variation of claim 12 in application 09/233,249. Thus, the rejection of claim 1 is not legally valid and should be reversed.

Claim 1 is patentably distinct from claim 12 in application 09/233,249

The Office has not established that the inventions (of pending claim 1 and claim 12 in application 09/233,249) are related. Where has the Office established that the inventions are even related? It hasn't. Thus, the Office has not established a basis for the nonstatutory obviousness-type double patenting rejection.

Even if the inventions (of pending claim 1 and claim 12 in application 09/233,249) were somehow shown to be related by the Office (which hasn't been established), the Office still has not shown that the inventions are not patentably distinct from each other. Conversely, the inventions, if somehow shown to be related, would still be patentably distinct from each other.

In the application's claim 12 the output can be generated through the output device responsive to input device input, transaction machine interface software, and at least one command instruction in an instruction document. Where is there a requirement in pending claim 1 that output be generated through the output device responsive to input device input, transaction

machine interface software, and at least one command instruction in an instruction document?

This is a patentably distinct feature.

Furthermore, in pending claim 1 the "instruction" is linked to the transaction function device carrying out a transaction function, whereas in the application's claim 12 the "instruction" is linked to output through the output device. This is yet another patentably distinct feature.

Even if the inventions were related (for sake of argument), they would be related as subcombinations. The inventions are patentably distinct if it can be shown (MPEP § 806.05(d)) that at least one subcombination is separately useable.

In such a relationship scenario, pending claim 1 would have separate utility (from the application's claim 12), such as use in an apparatus including a computer that can, without being *responsive to input* to an input device, cause a transaction function device to carry out a transaction function. Rather, in the utility of pending claim 1 the transaction function device can carry out the transaction function *responsive to a browser* processing at least one document (instead of responsive to input to an input device as required in the application's claim 12). That is, pending claim 1 (unlike application claim 12) does not link input device input to the transaction function device carrying out a transaction function.

Pending claim 1 has further separate utility (from the application's claim 12), such as use in an apparatus that can output a perceivable output from an output device without the output being responsive to input device input, transaction machine interface software, and at least one command instruction in an instruction document.

The application's claim 12 has separate utility (from the pending claim 1), such as use in an apparatus that can cause the transaction function device to carry out a transaction function

without being responsive to a browser processing at least one document including at least one instruction.

A legally valid obviousness-type double patenting rejection requires that pending claim 1 and the application claim 12 not be patentably distinct from each other. However, Appellants have shown otherwise. Appellants have shown that these claims, even if somehow shown to be related, would still be patentably distinct from each other. Thus, the provisional nonstatutory obviousness-type double patenting rejection of pending claim 1 (based on claim 12 of application 09/233,249) is not legally valid.

The Office has not established a *prima facie* case of obviousness with regard to pending claim 1

As previously discussed, neither claim 1 in application 10/980,209 nor claim 12 in application 09/233,249 discloses or suggests the features and relationships that are specifically recited in pending claim 1. It follows that a *prima facie* case of obviousness has not been established. Furthermore, both claim 1 in application 10/980,209 and claim 12 in application 09/233,249 are devoid of any such teaching or suggestion so as to produce the recited invention of pending claim 1. Therefore, Appellants respectfully submit that the rejection of claim 1 is not legally valid and should be reversed.

Appellants have shown independent claim 1 to be allowable. "If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious" (MPEP 2143.03). *In re Fine*, 5 USPQ2d 1596, 837 F.2d 1071 (Fed. Cir. 1988). Thus, Appellants respectfully submit that the claims that depend on claim 1 are allowable on at least this same basis.

### **Independent Claim 8**

The Action (on page 24) merely states that claim 8 is rejected "over claim 1 of copending Application No. 10/980209 and claim 12 of copending Application No. 09/233,249." The Action provides no valid reason for its allegation of obviousness.

The Action fails to identify any source of any teaching or suggestion in the relied upon claims to produce an obvious variation of the invention claimed by Appellants. Rather, the rejections consist of mere assertions of features alleged to be in the relied upon claims. The Office has also failed to document its reasoning for rejection on the record which is a mandatory requirement to allow appellate review of the basis for denial of a patent. *KSR International Co. v. Teleflex Inc.*, supra. It follows that the claim 8 rejections (which are based solely on an unsupported statement) are without merit.

Appellants are not required to prove patentability. Rather, the burden is on the Office to establish a *prima facie* case of obviousness under the law. Otherwise, the Office is legally required to grant a patent. Appellants are entitled to see and address the (alleged) evidence on which their patent grant is being denied. Since this evidence has not been presented, it must be concluded that it doesn't exist. It follows that the claim 8 rejections (which are based solely on an unsupported allegation) are without merit.

When a rejection hasn't been properly explained (which is the current situation), then Appellants haven't been given fair opportunity for rebuttal thereof. Where is there any evidence of record that the Office properly conducted a *Graham v. John Deere Co.* analysis? For example, what are the "differences" between the claims? No differences have been presented, as is required to sustain the rejection. What are the reasons that one having ordinary skill in the art

would find convincing for the allegation of obvious variation? No reasons have been presented. The Office has not even met the most basic of criteria for establishing a *prima facie* case of obviousness. Thus, the claim 8 rejections cannot be legally valid. On its face, the rejections (along with the clandestine reasons therefor) should be reversed.

Claim 8 is not an obvious variation of claim 1 in application 10/980,209

The application's claim 1 does not teach or suggest the features and relationships recited in pending claim 8. Where does the application's claim 1 teach or suggest the recited browser of pending claim 8? Where does the application's claim 1 teach or suggest the recited transaction function device of pending claim 8? Where does the application's claim 1 teach or suggest the recited relationship between the browser and the transaction function device, wherein the transaction function device can carry out its transaction function responsive to the browser's document processing? It doesn't. The Office has not established that pending claim 8 is an obvious variation of claim 1 in application 10/980,209.

Appellants have shown that claim 1 in application 10/980,209 alone does not teach or suggest all of the features and relationships that are specifically recited in pending claim 8. No secondary teaching or suggestion has been relied upon in the rejection of pending claim 8. Thus, the rejection is improperly based on mere assertions and not concrete evidence of record. *In re Zurko*, supra. *In re Lee*, supra. It follows that a *prima facie* case of obviousness has not been established.

Claim 1 in application 10/980,209 is devoid of any teaching or suggestion to produce the recited invention of pending claim 8. Therefore, Appellants respectfully submit that pending

claim 8 cannot be an obvious variation of claim 1 in application 10/980,209. Thus, the rejection of claim 8 is not legally valid and should be reversed.

Claim 8 is patentably distinct from claim 1 in application 10/980,209

The Office has not established that the inventions (of pending claim 8 and claim 1 in application 10/980,209) are related. Where has the Office established that the inventions are even related? It hasn't. Thus, the Office has not established a basis for the nonstatutory obviousness-type double patenting rejection.

Even if the inventions (of pending claim 8 and claim 1 in application 10/980,209) were somehow shown to be related by the Office (which hasn't been established), the Office still has not shown that the inventions are not patentably distinct from each other. Conversely, the inventions, if somehow shown to be related, would still be patentably distinct from each other.

The application's claim 1 is directed to a *method*, not an *apparatus* (like pending claim 8). Even if the inventions were related (for sake of argument), they would be related as (patentably distinct) process and apparatus for its practice (MPEP § 806.05(e)).

In such a relationship scenario, the process of the application's claim 1 can be practiced by an apparatus without a browser, unlike the apparatus of pending claim 8. Also, the process of the application's claim 1 can be used with an apparatus that does not require a transaction function device that can carry out a transaction function responsive to a document *received* by the browser. Where does the application's claim 1 receive any document? These are patentably distinct features.

The apparatus of pending claim 8 can be used to practice a process (unlike the process of application claim 1) that does not require operating at least one computer to *send* at least one



message from the machine. Also, the pending claim 8 apparatus can be used to practice a process (unlike the process of application claim 1) that does not require operating at least one computer to send the at least one first message responsive to at least one condition of the machine. Where does pending claim 8 send any document? These are also patentably distinct features.

Appellants have shown that the claims, if somehow shown to be related, would still be patentably distinct from each other. Thus, the provisional nonstatutory obviousness-type double patenting rejection of pending claim 8 (based on claim 1 of application 10/980,209) is not legally valid.

Claim 8 is not an obvious variation of claim 12 in application 09/233,249

The application's claim 12 does not teach or suggest the features and relationships recited in pending claim 8. Where does the application's claim 12 specifically teach or suggest the recited browser of pending claim 8? Where does the application's claim 12 teach or suggest the recited transaction function device of pending claim 8? Where does the application's claim 12 teach or suggest the recited relationship between the browser and the transaction function device, wherein the transaction function device can carry out a transaction function responsive to a document received by the browser? It doesn't. The Office has not established that pending claim 8 is an obvious variation of claim 12 in application 09/233,249.

Pending claim 8 recites that the transaction function device is operative to carry out the transaction function responsive to a document received by the browser. Unlike pending claim 8, the application's claim 12 recites that the computer is operative to cause the transaction function device to carry out the transaction function responsive to input to the input device. That is,

generally speaking, a transaction function device carrying out a transaction function is "responsive to a document received by a browser" in pending claim 8, but is differently "responsive to at least one first input to the first input device" in the application's claim 12.

In pending claim 8 the "document" is linked to the transaction function device carrying out a transaction function, whereas in the application's claim 12 the "document" is linked to output through the output device.

The Office appears to be reading into the application's claim 12 more than what it specifically teaches or suggests. Again, the Office can only rely on the claimed subject matter of claim 12, not the application's entire disclosure (which appears to be the situation).

Claim 8 is patentably distinct from claim 12 in application 09/233,249

The Office has not established that the inventions (of pending claim 8 and claim 12 in application 09/233,249) are related. Where has the Office established that the inventions are even related? It hasn't. Thus, the Office has not established a basis for the nonstatutory obviousness-type double patenting rejection.

Even if the inventions (of pending claim 8 and claim 12 in application 09/233,249) were somehow shown to be related by the Office (which hasn't been established), the Office still has not shown that the inventions are not patentably distinct from each other. Conversely, the inventions, if somehow shown to be related, would still be patentably distinct from each other.

Even if the inventions were related (for sake of argument), they would be related as (patentably distinct) subcombinations (MPEP § 806.05(d)). In such a relationship scenario, pending claim 8 would have separate utility (from the application's claim 12), such as in an apparatus including a computer that can, without being *responsive to input* to an input device,

cause a transaction function device to carry out a transaction function. In said utility of pending claim 8 the transaction function device can carry out the transaction function *responsive to a document that is received by a browser* (instead of responsive to input to an input device as required in the application's claim 12). That is, pending claim 8 (unlike application claim 12) does not link input device input to the transaction function device carrying out a transaction function. This is a patentably distinct feature.

Pending claim 8 has further separate utility (from the application's claim 12), such as in an apparatus without an output device. Where does pending claim 8 even require an output device? This is another patentably distinct feature.

Pending claim 8 has additional separate utility (from the application's claim 12), such as in an apparatus with an output device that can provide its output unrelated to input device input, transaction machine interface software, and a command instruction in an instruction document. There is no requirement in pending claim 8 that output be generated through an output device responsive to input device input, transaction machine interface software, and at least one command instruction in an instruction document. This is another patentably distinct feature.

The application's claim 12 has separate utility (from the pending claim 8), such as in an apparatus that can cause the transaction function device to carry out a transaction function without being responsive to a document received by a browser. This is yet another patentably distinct feature.

Appellants have shown that the claims, if somehow shown to be related, would still be patentably distinct from each other. Thus, the provisional nonstatutory obviousness-type double

patenting rejection of pending claim 8 (based on claim 12 of application 09/233,249) is not legally valid.

### **Independent Claim 9**

The Action (on page 24) merely states that claim 9 is rejected "over claim 1 of copending Application No. 10/980209 and claim 12 of copending Application No. 09/233,249." The Action provides no valid reason for its allegation of obviousness. Again, the Office fails to identify any source of any teaching or suggestion in the relied upon claims to produce an obvious variation of the invention claimed by Appellants. Rather, the rejections consist of mere assertions of features alleged to be in the relied upon claims. The Office has also failed to document any valid reasoning for the rejections on the record, which is a mandatory requirement to allow appellate review of the basis for denial of a patent. *KSR International Co. v. Teleflex Inc.*, supra.

For reasons already discussed (e.g., Appellants' remarks in support of the patentability of claim 8), the Office has not even met the most basic of criteria for establishing a *prima facie* case of obviousness. Thus, the claim 9 rejections cannot be legally valid. On its face the rejections should be reversed.

### **Claim 9 is not an obvious variation of claim 1 in application 10/980,209**

The application's claim 1 does not teach or suggest the features and relationships recited in pending claim 9. The application's claim 1 relates to operating at least one computer in the machine to send at least one message from the machine, responsive to at least one condition of the machine. Where does the application's claim 1 teach or suggest the pending claim 9 steps related to operating a browser, receiving a document with the browser, and carrying out at least one transaction function with a transaction function device responsive to the document? It

doesn't. The Office has not established that pending claim 9 is an obvious variation of claim 1 in application 10/980,209.

Appellants have shown that claim 1 in application 10/980,209 alone does not teach or suggest all of the features and relationships that are specifically recited in pending claim 9. No secondary teaching or suggestion has been relied upon in the rejection of pending claim 9. Thus, the rejection is improperly based on mere assertions and not concrete evidence of record. *In re Zurko*, supra. *In re Lee*, supra. It follows that a *prima facie* case of obviousness has not been established.

Claim 1 in application 10/980,209 is devoid of any teaching or suggestion to produce the recited invention of pending claim 9. Therefore, Appellants respectfully submit that pending claim 9 cannot be an obvious variation of claim 1 in application 10/980,209. Thus, the rejection of claim 9 is not legally valid and should be reversed.

Claim 9 is patentably distinct from claim 1 in application 10/980,209

The Office has not established that the inventions (of pending claim 9 and claim 1 in application 10/980,209) are related. Where has the Office established that the inventions are even related? It hasn't. Thus, the Office has not established a basis for the nonstatutory obviousness-type double patenting rejection.

Even if the inventions (of pending claim 9 and claim 1 in application 10/980,209) were somehow shown to be related by the Office (which hasn't been established), the Office still has not shown that the inventions are not patentably distinct from each other. Conversely, the inventions, if somehow shown to be related, would still be patentably distinct from each other.

Even if the inventions were related (for sake of argument), they would still be patentably distinct. In such a relationship scenario, pending claim 9 would have separate utility (from the application's claim 1), such as in a process that does not require operating at least one computer to send at least one message responsive to at least one condition of the machine. Where does pending claim 9 send any document? This is a patentably distinct feature.

Similarly, the application's claim 1 would have separate utility (from pending claim 9), such as in a process that does not require carrying out at least one transaction function with a transaction function device responsive to a document. This is another patentably distinct feature.

Even more reasons why the claims are patentably distinct from each other can be ascertained from Appellants' remarks in support of the patentability of claim 1.

Appellants have shown that the claims, if somehow shown to be related, would still be patentably distinct from each other. Thus, the provisional nonstatutory obviousness-type double patenting rejection of pending claim 9 (based on claim 1 of application 10/980,209) is not legally valid.

Claim 9 is not an obvious variation of claim 12 in application 09/233,249

The application's claim 12 does not teach or suggest the features and relationships recited in pending claim 9. Where does the application's claim 12 teach or suggest operating a browser, receiving a document with the browser, and carrying out at least one transaction function with a transaction function device responsive to the document, as in pending claim 9? It doesn't. The Office has not established that pending claim 9 is an obvious variation of claim 12 in application 09/233,249.

Appellants have shown that claim 12 in application 09/233,249 alone does not teach or suggest all of the features and relationships that are specifically recited in pending claim 9. No secondary teaching or suggestion has been relied upon in the rejection of pending claim 9. Thus, the rejection is improperly based on mere assertions and not concrete evidence of record. *In re Zurko*, supra. *In re Lee*, supra. It follows that a *prima facie* case of obviousness has not been established.

Claim 12 in application 09/233,249 is devoid of any teaching or suggestion to produce the recited invention of pending claim 9. Therefore, Appellants respectfully submit that pending claim 9 cannot be an obvious variation of claim 12 in application 09/233,249. Thus, the rejection of claim 9 is not legally valid and should be reversed.

Claim 9 is patentably distinct from claim 12 in application 09/233,249

The Office has not established that the inventions (of pending claim 9 and claim 12 in application 09/233,249) are related. Where has the Office established that the inventions are even related? It hasn't. Thus, the Office has not established a basis for the nonstatutory obviousness-type double patenting rejection.

Even if the inventions (of pending claim 9 and claim 12 in application 09/233,249) were somehow shown to be related by the Office (which hasn't been established), the Office still has not shown that the inventions are not patentably distinct from each other. Conversely, the inventions, if somehow shown to be related, would still be patentably distinct from each other.

Pending claim 9 is directed to a *method*, not an *apparatus* (like application claim 12). Even if the inventions were related (for sake of argument), they would be related as (patentably distinct) process and apparatus for its practice (MPEP § 806.05(e)).

In such a relationship scenario, the process of the pending claim 9 can be practiced by an apparatus without requiring a computer that causes a transaction function device to carry out a transaction function responsive to input to an input device. Rather, pending claim 9 can carry out a transaction function responsive to a document (instead of responsive to input to an input device as required in the application's claim 12). Pending claim 9 (unlike application claim 12) does not link input device input to a transaction function device carrying out a transaction function. This is a patentably distinct feature.

The process of pending claim 9 can also be practiced by apparatus without an output device (unlike the application's claim 12). The process of pending claim 9 can also be practiced by yet another apparatus (different from the application's claim 12), such as in an apparatus with an output device that can provide its output unrelated to input device input, transaction machine interface software, and a command instruction in an instruction document. These are also patentably distinct features.

The application's claim 12 can be used in a process (different from that of pending claim 9), such as one causing the transaction function device to carry out a transaction function without being responsive to a document received by a browser. This is another patentably distinct feature.

Even more reasons why the claims are patentably distinct from each other can be ascertained from Appellants' remarks in support of the patentability of claim 1.

Appellants have shown that the claims, if somehow shown to be related, would still be patentably distinct from each other. Thus, the provisional nonstatutory obviousness-type double



patenting rejection of pending claim 9 (based on claim 12 of application 09/233,249) is not legally valid.

Appellants have shown independent claim 9 to be allowable. "If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious" (MPEP 2143.03). *In re Fine*, supra. Thus, Appellants respectfully submit that the claims that depend on claim 9 are allowable on at least the same basis.

### **Independent Claim 11**

The Action (on page 24) merely states that claim 11 is rejected "over claim 1 of copending Application No. 10/980209 and claim 12 of copending Application No. 09/233,249." The Action provides no valid reason for its allegation of obviousness. Again, the Office fails to identify any source of any teaching or suggestion in the relied upon claims to produce an obvious variation of the invention claimed by Appellants. Rather, the rejections consist of mere assertions of features alleged to be in the relied upon claims. The Office has also failed to document any valid reasoning for the rejections on the record, which is a mandatory requirement to allow appellate review of the basis for denial of a patent. *KSR International Co. v. Teleflex Inc.*, supra. It follows that the claim 11 rejections (which are based solely on an unsupported statement) are without merit.

For reasons already discussed (e.g., Appellants' remarks in support of the patentability of claim 8), the Office has not even met the most basic of criteria for establishing a *prima facie* case of obviousness. Thus, the claim 11 rejections cannot be legally valid. On its face the rejections should be reversed.

Appellants' remarks in support of the patentability of claims 1 and 8 are incorporated herein by reference.

Claim 11 is not an obvious variation of claim 1 in application 10/980,209

The application's claim 1 does not teach or suggest the features and relationships recited in pending claim 11. The application's claim 1 relates to operating at least one computer in the machine to send at least one message from the machine, responsive to at least one condition of the machine. Where does the application's claim 1 teach or suggest the pending claim 11 steps related to operating a browser, receiving a document (including a transaction instruction embedded therein) with the browser, and carrying out at least one transaction function with a transaction function device responsive to the document (including the transaction instruction)? It doesn't. Even more reasons why pending claim 11 is not an obvious variation of the application's claim 1 can be ascertained from Appellants' previous remarks in support of the patentability of claim 1. The Office has not established that pending claim 11 is an obvious variation of claim 1 in application 10/980,209.

Appellants have shown that claim 1 in application 10/980,209 alone does not teach or suggest all of the features and relationships that are specifically recited in pending claim 11. No secondary teaching or suggestion has been relied upon in the rejection of pending claim 11. Thus, the rejection is improperly based on mere assertions and not concrete evidence of record. *In re Zurko*, supra. *In re Lee*, supra. It follows that a *prima facie* case of obviousness has not been established.

Claim 1 in application 10/980,209 is devoid of any teaching or suggestion to produce the recited invention of pending claim 11. Therefore, Appellants respectfully submit that pending

claim 11 cannot be an obvious variation of claim 1 in application 10/980,209. Thus, the rejection of claim 11 is not legally valid and should be reversed.

Claim 11 is patentably distinct from claim 1 in application 10/980,209

The Office has not established that the inventions (of pending claim 11 and claim 1 in application 10/980,209) are related. Where has the Office established that the inventions are even related? It hasn't. Thus, the Office has not established a basis for the nonstatutory obviousness-type double patenting rejection.

Even if the inventions (of pending claim 11 and claim 1 in application 10/980,209) were somehow shown to be related by the Office (which hasn't been established), the Office still has not shown that the inventions are not patentably distinct from each other. Conversely, the inventions, if somehow shown to be related, would still be patentably distinct from each other.

Even if the inventions were related (for sake of argument), they would still be patentably distinct. In such a relationship scenario, pending claim 11 would have separate utility (from the application's claim 1), such as in a process that does not require operating at least one computer to send at least one message responsive to at least one condition of the machine. Where does pending claim 11 send any document? This is a patentably distinct feature.

Similarly, the application's claim 1 would have separate utility (from pending claim 11), such as in a process that does not require operating a browser, receiving a document (including a transaction instruction embedded therein) with the browser, and carrying out at least one transaction function with a transaction function device responsive to the document (including the transaction instruction). These are other patentably distinct features. Even more reasons why the

claims are patentably distinct from each other can be ascertained from Appellants' previous remarks in support of the patentability of claim 1.

Appellants have shown that the claims, if somehow shown to be related, would still be patentably distinct from each other. Thus, the provisional nonstatutory obviousness-type double patenting rejection of pending claim 11 (based on claim 1 of application 10/980,209) is not legally valid.

Claim 11 is not an obvious variation of claim 12 in application 09/233,249

The application's claim 12 does not teach or suggest the features and relationships recited in pending claim 11. Where does the application's claim 12 teach or suggest operating a browser, receiving a document (including a transaction instruction embedded therein) with the browser, and carrying out at least one transaction function with a transaction function device responsive to the document (including the transaction instruction), as in pending claim 11? It doesn't. The Office has not established that pending claim 11 is an obvious variation of claim 12 in application 09/233,249.

Appellants have shown that claim 12 in application 09/233,249 alone does not teach or suggest all of the features and relationships that are specifically recited in pending claim 11. No secondary teaching or suggestion has been relied upon in the rejection of pending claim 11. Thus, the rejection is improperly based on mere assertions and not concrete evidence of record. *In re Zurko*, supra. *In re Lee*, supra. It follows that a *prima facie* case of obviousness has not been established.

Claim 12 in application 09/233,249 is devoid of any teaching or suggestion to produce the recited invention of pending claim 11. Therefore, Appellants respectfully submit that pending

claim 11 cannot be an obvious variation of claim 12 in application 09/233,249. Thus, the rejection of claim 11 is not legally valid and should be reversed.

Claim 11 is patentably distinct from claim 12 in application 09/233,249

The Office has not established that the inventions (of pending claim 11 and claim 12 in application 09/233,249) are related. Where has the Office established that the inventions are even related? It hasn't. Thus, the Office has not established a basis for the nonstatutory obviousness-type double patenting rejection.

Even if the inventions (of pending claim 11 and claim 12 in application 09/233,249) were somehow shown to be related by the Office (which hasn't been established), the Office still has not shown that the inventions are not patentably distinct from each other. Conversely, the inventions, if somehow shown to be related, would still be patentably distinct from each other.

Pending claim 11 is directed to a *method*, not an *apparatus* (like application claim 12). Even if the inventions were related (for sake of argument), they would be related as (patentably distinct) process and apparatus for its practice (MPEP § 806.05(e)).

In such a relationship scenario, the process of pending claim 11 can be practiced by an apparatus including a computer that can, without being responsive to input to an input device, cause a transaction function device to carry out a transaction function. Rather, the transaction function device can carry out the transaction function responsive to a document including a transaction instruction embedded therein (instead of responsive to input to an input device as required in the application's claim 12). Pending claim 11 (unlike application claim 12) does not link input device input to the transaction function device carrying out a transaction function. This is a patentably distinct feature.

The process of pending claim 11 can also be practiced by apparatus without an output device (unlike the application's claim 12). This is another patentably distinct feature.

The process of pending claim 11 can also be practiced by yet another apparatus (different from the application's claim 12), such as in an apparatus with an output device that can provide its output unrelated to input device input, transaction machine interface software, and a command instruction in an instruction document. These are further patentably distinct features.

The application's claim 12 can be used in a process (different from that of pending claim 11), such as causing the transaction function device to carry out a transaction function without being responsive to a document received by a browser. This is another patentably distinct feature.

Even more reasons why the claims are patentably distinct from each other can be ascertained from Appellants' previous remarks in support of the patentability of claim 1.

Appellants have shown that the claims, if somehow shown to be related, would still be patentably distinct from each other. Thus, the provisional nonstatutory obviousness-type double patenting rejection of pending claim 11 (based on claim 12 of application 09/233,249) is not legally valid.

### **Independent Claim 13**

The Action (on page 24) merely states that claim 13 is rejected "over claim 1 of copending Application No. 10/980209 and claim 12 of copending Application No. 09/233,249." The Action provides no valid reason for its allegation of obviousness. Again, the Office fails to identify any source of any teaching or suggestion in the relied upon claims to produce an obvious variation of the invention claimed by Appellants. Rather, the rejections consist of mere

assertions of features alleged to be in the relied upon claims. The Office has also failed to document any valid reasoning for the rejections on the record, which is a mandatory requirement to allow appellate review of the basis for denial of a patent. *KSR International Co. v. Teleflex Inc.*, supra. It follows that the claim 13 rejections (which are based solely on an unsupported statement) are without merit.

For reasons already discussed (e.g., Appellants' remarks in support of the patentability of claim 8), the Office has not even met the most basic of criteria for establishing a *prima facie* case of obviousness. Thus, the claim 13 rejections cannot be legally valid. On its face the rejections should be reversed.

Appellants' remarks in support of the patentability of claims 1 and 8 are incorporated herein by reference.

Claim 13 is not an obvious variation of claim 1 in application 10/980,209

The application's claim 1 does not teach or suggest the features and relationships recited in pending claim 13. The application's claim 1 is a process that relates to operating at least one computer in a machine to send at least one message from the machine, responsive to at least one condition of the machine. Where does the application's claim 1 teach or suggest the pending claim 13 apparatus features that can cause a banking transaction to be carried out through operation of a transaction function device responsive to a document? It doesn't. The Office has not established that pending claim 13 is an obvious variation of claim 1 in application 10/980,209.

Appellants have shown that claim 1 in application 10/980,209 alone does not teach or suggest all of the features and relationships that are specifically recited in pending claim 13. No

secondary teaching or suggestion has been relied upon in the rejection of pending claim 13. Thus, the rejection is improperly based on mere assertions and not concrete evidence of record. *In re Zurko*, supra. *In re Lee*, supra. It follows that a *prima facie* case of obviousness has not been established.

Claim 1 in application 10/980,209 is devoid of any teaching or suggestion to produce the recited invention of pending claim 13. Therefore, Appellants respectfully submit that pending claim 13 cannot be an obvious variation of claim 1 in application 10/980,209. Thus, the rejection of claim 13 is not legally valid and should be reversed.

Claim 13 is patentably distinct from claim 1 in application 10/980,209

The Office has not established that the inventions (of pending claim 13 and claim 1 in application 10/980,209) are related. Where has the Office established that the inventions are even related? It hasn't. Thus, the Office has not established a basis for the nonstatutory obviousness-type double patenting rejection.

Even if the inventions (of pending claim 13 and claim 1 in application 10/980,209) were somehow shown to be related by the Office (which hasn't been established), the Office still has not shown that the inventions are not patentably distinct from each other. Conversely, the inventions, if somehow shown to be related, would still be patentably distinct from each other.

Even if the inventions were related (for sake of argument), they would still be patentably distinct. In such a relationship scenario, application's claim 1 and pending claim 13 can be related as process and apparatus for its practice. The application's claim 1 is directed to a *method*, not an *apparatus* (like pending claim 13). This is a patentably distinct feature. The process of the application's claim 1 can be practiced with an apparatus not having a computer that



can cause a banking transaction to be carried out through operation of a transaction function device responsive to a document. This is another patentably distinct feature.

The apparatus of pending claim 13 can be used to practice a process (unlike the process of application claim 1) that does not require operating at least one computer to send at least one message from the machine. Also, the pending claim 13 apparatus can be used to practice a process (unlike the process of application claim 1) that does not require operating at least one computer to send the at least one first message responsive to at least one condition of the machine. Where does pending claim 13 send any document? These are further patentably distinct features.

Even more reasons why the claims are patentably distinct from each other can be ascertained from Appellants' previous remarks in support of the patentability of claim 1.

Appellants have shown that the claims, if somehow shown to be related, would still be patentably distinct from each other. Thus, the provisional nonstatutory obviousness-type double patenting rejection of pending claim 13 (based on claim 1 of application 10/980,209) is not legally valid.

Claim 13 is not an obvious variation of claim 12 in application 09/233,249

The application's claim 12 does not teach or suggest the features and relationships recited in pending claim 13. In pending claim 13 a computer can cause a banking transaction to be carried out through operation of a transaction function device responsive to a document. Dissimilarly, the application's claim 12 recites that the computer is operative to cause the transaction function device to carry out a transaction function responsive to input to the input device. That is, generally speaking, a transaction function device carrying out a banking

transaction is "responsive to a document" in pending claim 13, but is differently "responsive to at least one first input to the first input device" in the application's claim 12. Where does the application's claim 12 teach or suggest the ability to carry out a banking transaction through operation of a transaction function device responsive to a document? It doesn't. The Office has not established that pending claim 13 is an obvious variation of claim 12 in application 09/233,249.

The Office appears to be reading into the application's claim 12 more than what it specifically teaches or suggests. Again, the Office can only rely on the claimed subject matter of claim 12, not the application's entire disclosure (which appears to be the situation).

Appellants have shown that claim 12 in application 09/233,249 alone does not teach or suggest all of the features and relationships that are specifically recited in pending claim 13. No secondary teaching or suggestion has been relied upon in the rejection of pending claim 13. Thus, the rejection is improperly based on mere assertions and not concrete evidence of record. *In re Zurko*, supra. *In re Lee*, supra. It follows that a *prima facie* case of obviousness has not been established.

Claim 12 in application 09/233,249 is devoid of any teaching or suggestion to produce the recited invention of pending claim 13. Therefore, Appellants respectfully submit that pending claim 13 cannot be an obvious variation of claim 12 in application 09/233,249. Thus, the rejection of claim 13 is not legally valid and should be reversed.

Claim 13 is patentably distinct from claim 12 in application 09/233,249

The Office has not established that the inventions (of pending claim 13 and claim 12 in application 09/233,249) are related. Where has the Office established that the inventions are

even related? It hasn't. Thus, the Office has not established a basis for the nonstatutory obviousness-type double patenting rejection.

Even if the inventions (of pending claim 13 and claim 12 in application 09/233,249) were somehow shown to be related by the Office (which hasn't been established), the Office still has not shown that the inventions are not patentably distinct from each other. Conversely, the inventions, if somehow shown to be related, would still be patentably distinct from each other.

Pending claim 13 has separate utility (from the application's claim 12), because it can be used without linking input device input to a transaction function device carrying out a transaction. This is a patentably distinct feature.

Likewise, the application's claim 12 has separate utility (from pending claim 13), because it can be used without linking a document to a transaction function device carrying out a transaction. This is a patentably distinct feature.

In pending claim 13 the "document" is linked to a transaction function device carrying out a banking transaction, whereas in the application's claim 12 the "document" is linked to output through an output device. Where does pending claim 13 even require an output device? This is another patentably distinct feature.

Furthermore, in the application's claim 12 the output can be generated through the output device responsive to input device input, transaction machine interface software, and at least one command instruction in an instruction document. There is no requirement in pending claim 13 that output be generated through an output device responsive to input device input, transaction machine interface software, and at least one command instruction in an instruction document. This is yet another patentably distinct feature.

Appellants have shown that the claims, if somehow shown to be related, would still be patentably distinct from each other. Thus, the provisional nonstatutory obviousness-type double patenting rejection of pending claim 13 (based on claim 12 of application 09/233,249) is not legally valid.

Appellants have also shown independent claim 13 to be allowable. Thus, Appellants respectfully submit that the claims dependent on claim 13 are also allowable.

### **Independent Claim 16**

The Action (on page 24) merely states that claim 16 is rejected "over claim 1 of copending Application No. 10/980209 and claim 12 of copending Application No. 09/233,249." The Action provides no valid reason for its allegation of obviousness. Again, the Office fails to identify any source of any teaching or suggestion in the relied upon claims to produce an obvious variation of the invention claimed by Appellants. Rather, the rejections consist of mere assertions of features alleged to be in the relied upon claims. The Office has also failed to document any valid reasoning for the rejections on the record, which is a mandatory requirement to allow appellate review of the basis for denial of a patent. *KSR International Co. v. Teleflex Inc.*, supra. It follows that the claim 13 rejections (which are based solely on an unsupported statement) are without merit.

For reasons already discussed (e.g., Appellants' remarks in support of the patentability of claim 8), the Office has not even met the most basic of criteria for establishing a *prima facie* case of obviousness. Thus, the claim 16 rejections cannot be legally valid. On its face the rejections should be reversed. Appellants' remarks in support of the patentability of claims 1 and 8 are also incorporated herein by reference.

Claim 16 is not an obvious variation of claim 1 in application 10/980,209

The application's claim 1 does not teach or suggest the features and relationships recited in pending claim 16. The application's claim 1 is a process that relates to operating at least one computer in a machine to send at least one message from the machine, responsive to at least one condition of the machine. Where does the application's claim 1 teach or suggest the pending claim 16 steps related to processing a document with a computer, and carrying out at least a portion of a banking transaction with a transaction function device responsive to processing the document with the computer? It doesn't. The Office has not established that pending claim 16 is an obvious variation of claim 1 in application 10/980,209.

Appellants have shown that claim 1 in application 10/980,209 alone does not teach or suggest all of the features and relationships that are specifically recited in pending claim 16. No secondary teaching or suggestion has been relied upon in the rejection of pending claim 16. Thus, the rejection is improperly based on mere assertions and not concrete evidence of record. *In re Zurko*, supra. *In re Lee*, supra. It follows that a *prima facie* case of obviousness has not been established.

Claim 1 in application 10/980,209 is devoid of any teaching or suggestion to produce the recited invention of pending claim 16. Therefore, Appellants respectfully submit that pending claim 16 cannot be an obvious variation of claim 1 in application 10/980,209. Thus, the rejection of claim 16 is not legally valid and should be reversed.

Claim 16 is patentably distinct from claim 1 in application 10/980,209

The Office has not established that the inventions (of pending claim 16 and claim 1 in application 10/980,209) are related. Where has the Office established that the inventions are

even related? It hasn't. Thus, the Office has not established a basis for the nonstatutory obviousness-type double patenting rejection.

Even if the inventions (of pending claim 16 and claim 1 in application 10/980,209) were somehow shown to be related by the Office (which hasn't been established), the Office still has not shown that the inventions are not patentably distinct from each other. Conversely, the inventions, if somehow shown to be related, would still be patentably distinct from each other.

In such a relationship scenario, pending claim 16 would have separate utility (from the application's claim 1), such as in a process that does not require operating at least one computer to send at least one message responsive to at least one condition of the machine. Where does pending claim 16 send any document? This is a patentably distinct feature.

Similarly, the application's claim 1 would have separate utility (from pending claim 16), such as in a process that does not require processing a document with a computer, and carrying out at least a portion of a banking transaction with a transaction function device responsive to processing the document with the computer. These are other patentably distinct features.

Appellants have shown that the claims, if somehow shown to be related, would still be patentably distinct from each other. Thus, the provisional nonstatutory obviousness-type double patenting rejection of pending claim 16 (based on claim 1 of application 10/980,209) is not legally valid.

Claim 16 is not an obvious variation of claim 12 in application 09/233,249

The application's claim 12 does not teach or suggest the features and relationships recited in pending claim 16. Where does the application's claim 12 teach or suggest steps related to processing a document with a computer, and carrying out at least a portion of a banking

transaction with a transaction function device responsive to processing the document with the computer, as in pending claim 16? It doesn't. The Office has not established that pending claim 16 is an obvious variation of claim 12 in application 09/233,249.

Appellants have shown that claim 12 in application 09/233,249 alone does not teach or suggest all of the features and relationships that are specifically recited in pending claim 16. No secondary teaching or suggestion has been relied upon in the rejection of pending claim 16. Thus, the rejection is improperly based on mere assertions and not concrete evidence of record. *In re Zurko*, supra. *In re Lee*, supra. It follows that a *prima facie* case of obviousness has not been established.

Claim 12 in application 09/233,249 is devoid of any teaching or suggestion to produce the recited invention of pending claim 16. Therefore, Appellants respectfully submit that pending claim 16 cannot be an obvious variation of claim 12 in application 09/233,249. Thus, the rejection of claim 16 is not legally valid and should be reversed.

Claim 16 is patentably distinct from claim 12 in application 09/233,249

The Office has not established that the inventions (of pending claim 16 and claim 12 in application 09/233,249) are related. Where has the Office established that the inventions are even related? It hasn't. Thus, the Office has not established a basis for the nonstatutory obviousness-type double patenting rejection.

Even if the inventions (of pending claim 16 and claim 12 in application 09/233,249) were somehow shown to be related by the Office (which hasn't been established), the Office still has not shown that the inventions are not patentably distinct from each other. Conversely, the inventions, if somehow shown to be related, would still be patentably distinct from each other.

Pending claim 16 is directed to a *method*, not an *apparatus* (like application claim 12). This is a patentably distinct feature.

The process of pending claim 16 can be practiced by an apparatus including a computer that can, without being responsive to input to an input device, carry out at least a portion of a banking transaction. The process of pending claim 16 can carry out the portion of a banking transaction responsive to processing a document (instead of responsive to input to an input device as required in the application's claim 12). That is, pending claim 16 (unlike application claim 12) does not link input device input to carrying out the portion of a banking transaction. This is another patentably distinct feature.

The process of pending claim 16 can also be practiced with an apparatus without an output device (unlike the application's claim 12). The process of pending claim 16 can also be practiced by yet another apparatus (different from the application's claim 12), such as in an apparatus with an output device that can provide its output unrelated to input device input, transaction machine interface software, and a command instruction in an instruction document. These are further patentably distinct features.

The application's claim 12 can be used in a process (different from that of pending claim 16), such as causing the transaction function device to carry out a transaction function without being responsive to processing a document with a computer. This is yet another patentably distinct feature.

Appellants have shown that the claims, if somehow shown to be related, would still be patentably distinct from each other. Even more reasons why the claims are patentably distinct from each other can be ascertained from Appellants' previous remarks in support of the



patentability of pending claim 1. The provisional nonstatutory obviousness-type double patenting rejection of pending claim 16 (based on claim 12 of application 09/233,249) is not legally valid.

Appellants have shown independent claim 16 to be allowable. Thus, Appellants respectfully submit that the claims that depend on claim 16 are also allowable.

### **The Dependent Claims**

Dependent claims 2-7, 10, 14-15, and 17-30 were provisionally rejected as unpatentable on the ground of nonstatutory obviousness-type double patenting.

### **Provisional rejections based on canceled claims**

#### **Claims 2-7, 18-21, and 29**

Pending claims 2-7, 18-21, and 29 were provisionally rejected as unpatentable on the ground of nonstatutory obviousness-type double patenting over at least one of canceled claims 2-7 of application 10/980,209.

Claims 2-7 were canceled in application 10/980,209 at its initial filing on November 2, 2004. That is, the claims in application 10/980,209 that the Office continues to rely upon as a basis for rejection have not been pending for many years. Any rejection that relies on one of the canceled claims 2-7 in application 10/980,209 is without merit. Thus, the rejection of pending claims 2-7, 18-21, and 29 should be reversed. These claims no longer need to be discussed herein.

It is shameful that the Office was made fully aware of the status of canceled claims 2-7 in the Appeal Brief dated November 6, 2006, yet the rejections based thereon continue to be made.

In view of the assigned Group's inability to efficiently examine this application (e.g., eight non-final rejections, not reading Appellants' remarks, etc.), Appellants again respectfully submit that this application should be transferred to an examining Group that is more qualified.

**Provisional rejections not based on a secondary reference**

**Claim 14**

Pending claim 14 was provisionally rejected as unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209.

Pending claim 14 depends from claim 13. Appellants have already shown that pending claim 13 is not an obvious variation of claim 1 of application 10/980,209. "If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious" (MPEP 2143.03). *In re Fine*, supra. Pending claim 14 also has features additional to claim 13.

Furthermore, where does claim 1 of application 10/980,209 teach or suggest a computer that includes document handling software, where the computer is operative to carry out a banking transaction responsive to the document handling software processing a document? The Office has not established a *prima facie* case of obviousness with regard to pending claim 14.

**Claim 25**

Pending claim 25 was provisionally rejected as unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209.

Pending claim 25 depends from claim 16. Appellants have already shown that pending claim 16 is not an obvious variation of claim 1 of application 10/980,209. Thus, Appellants respectfully submit that the claim 25 is also allowable.

Furthermore, where does claim 1 of application 10/980,209 teach or suggest that an HTML document is processed by a computer? The Office has not established a *prima facie* case of obviousness with regard to pending claim 25.

#### **Claim 28**

Pending claim 28 was provisionally rejected as unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209.

Pending claim 28 depends from claim 14/13. Appellants have already shown that pending claims 13 and 14 are not an obvious variation of claim 1 of application 10/980,209. Thus, Appellants respectfully submit that the claim 28 is also allowable.

Furthermore, where does claim 1 of application 10/980,209 teach or suggest a computer that is adapted to automatically operate a transaction function device responsive to a processing of a document with document handling software? The Office has not established a *prima facie* case of obviousness with regard to pending claim 28.

#### **Provisional rejections based on a secondary reference**

#### **Claim 10**

Pending claim 10 was provisionally rejected as unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209 in view of Wagner.

Pending claim 10 depends from claim 9. Appellants have already shown that pending claim 9 is not an obvious variation of claim 1 of application 10/980,209. Appellants' claim 9 remarks are herein incorporated by reference.

Wagner cannot alleviate the previously discussed deficiencies of claim 1 of application 10/980,209 with respect to pending claim 9, because Wagner also does not teach or suggest Appellants' recited features which are not found therein. Nor has Wagner been relied upon for such purpose. Wagner is not directed to browser operation, including receiving at least one HTML format document with a browser. Where does Wagner even mention "browser"?

Nor does Wagner teach or suggest the additionally recited features in claim 10. The Action is silent as to where Wagner allegedly teaches or suggests the recited features. Nor does Wagner teach or suggest producing an output through an output device responsive to the at least one HTML format document in the manner recited. For reasons previously discussed, Wagner is also non-enabling. The Office has not established a *prima facie* case of obviousness with regard to pending claim 10.

#### **Claim 15**

Pending claim 15 was provisionally rejected as unpatentable on the ground of nonstatutory obviousness-type double patenting over *either* claim 1 of application 10/980,209 in view of Watanabe *or* claim 12 of application 09/233,249 in view of Watanabe.

Pending claim 15 depends from claim 13. Appellants have already shown that pending claim 13 is not an obvious variation of *either* claim 1 of application 10/980,209 *or* claim 12 of application 09/233,249. Appellants' claim 13 remarks are herein incorporated by reference.

Watanabe cannot alleviate the previously discussed deficiencies of *either* claim 1 of application 10/980,209 *or* claim 12 of application 09/233,249 with respect to pending claim 13, because Watanabe also does not teach or suggest Appellants' recited features which are not found therein. Nor has Watanabe been relied upon for such purpose.

Nor does Watanabe teach or suggest the additionally recited features in claim 15.

Watanabe is only relied upon for a "note dispenser". The Office has not established a *prima facie* case of obviousness with regard to pending claim 15.

#### **Claim 17**

Pending claim 17 was provisionally rejected as unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209 in view of Watanabe.

Pending claim 17 depends from claim 16. Appellants have already shown that pending claim 16 is not an obvious variation of claim 1 of application 10/980,209. Appellants' claim 16 remarks are herein incorporated by reference.

Watanabe cannot alleviate the previously discussed deficiencies of claim 1 of application 10/980,209 with respect to pending claim 16, because Watanabe also does not teach or suggest Appellants' recited features which are not found therein. Nor has Watanabe been relied upon for such purpose.

Nor does Watanabe teach or suggest the additionally recited features in pending claim 17. Watanabe is only relied upon for a "note dispenser". The Office has not established a *prima facie* case of obviousness with regard to pending claim 17.

#### **Claim 22**

Pending claim 22 was provisionally rejected as unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209 in view of Wagner.

Pending claim 22 depends from claim 16. Appellants have already shown that pending claim 16 is not an obvious variation of claim 1 of application 10/980,209. Appellants' claim 16 remarks are herein incorporated by reference.

Wagner cannot alleviate the previously discussed deficiencies of claim 1 of application 10/980,209 with respect to pending claim 16, because Wagner also does not teach or suggest Appellants' recited features which are not found therein. Nor has Wagner been relied upon for such purpose.

Nor does Wagner teach or suggest the additionally recited features in claim 22. The Action is silent as to where Wagner allegedly teaches or suggests the recited features. Nor does Wagner teach or suggest providing output in the manner recited. For reasons previously discussed above, Wagner is also non-enabling. The Office has not established a *prima facie* case of obviousness with regard to pending claim 22.

### **Claim 23**

Pending claim 23 was provisionally rejected as unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209 in view of Wagner.

Pending claim 23 depends from claim 22/16. Appellants have already shown that pending claims 16 and 22 are not an obvious variation of claim 1 of application 10/980,209 in view of Wagner.

Nor does Wagner teach or suggest the additionally recited features in claim 23. The Action is silent as to where Wagner allegedly teaches or suggests the recited features. Nor does Wagner teach or suggest providing output in the manner recited. For reasons previously

discussed, Wagner is also non-enabling. The Office has not established a *prima facie* case of obviousness with regard to pending claim 23.

#### **Claim 24**

Pending claim 24 was provisionally rejected as unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209 in view of Okamoto.

Pending claim 24 depends from claim 23/22/16. The Office (on Action page 19) admits that application 10/980,209 does not teach or suggest "providing at least one output responsive to the browser software processing the at least one mark up language document." That is, the Office admits that application 10/980,209 does not teach or suggest the pending claim 23 features. As a result, the Office relies on Wagner in the rejection of claim 23. However, unlike the claim 23 rejection, the rejection of claim 24 (which depends on claim 23) is absent Wagner. Therefore, based on the Office's own admission of deficiency, the rejection of claim 24 is without merit.

Nor does Okamoto teach or suggest the recited features of claim 23 and the additionally recited features in claim 24. The Action is silent as to where Okamoto allegedly teaches or suggests the recited features. Nor does Okamoto teach or suggest providing "visual output through a screen" in the manner recited. Wagner is also non-enabling. The Office has not established a *prima facie* case of obviousness with regard to pending claim 24.

### **Claim 26**

Pending claim 26 was provisionally rejected as unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209 in view of Wagner.

Pending claim 26 depends from claim 16. Appellants have already shown that pending claim 16 is not an obvious variation of claim 1 of application 10/980,209.

Wagner cannot alleviate the previously discussed deficiencies of claim 1 of application 10/980,209 with respect to pending claim 16, because Wagner also does not teach or suggest Appellants' recited features which are not found therein. Nor has Wagner been relied upon for such purpose.

Nor does Wagner teach or suggest the additionally recited features in claim 26. The Action is silent as to where Wagner allegedly teaches or suggests the recited features. Nor does Wagner teach or suggest processing a document to cause action in the manner recited. For reasons previously discussed, Wagner is also non-enabling. The Office has not established a *prima facie* case of obviousness with regard to pending claim 26.

### **Claim 27**

Pending claim 27 was provisionally rejected as unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209 in view of Merriam Webster Dictionary ("Merriam").

Pending claim 27 depends from claim 16. Appellants have already shown that pending claim 16 is not an obvious variation of claim 1 of application 10/980,209. Thus, Appellants respectfully submit that the claim 27 is also allowable.



Merriam cannot alleviate the previously discussed deficiencies of claim 1 of application 10/980,209 with respect to pending claim 16, because Merriam also does not teach or suggest Appellants' recited features which are not found therein. Nor has Merriam been relied upon for such purpose.

The Action infers that claim 1 of application 10/980,209 does not teach or suggest the additionally recited features of claim 27. Nor does Merriam teach or suggest the features in claim 27. The Action is silent as to where Merriam allegedly teaches or suggests the recited features. Nor does Merriam teach or suggest a computer that is operative to cause carrying out of a portion of a banking transaction responsive to at least one software applet. Thus, the rejection is improperly based on mere assertions and not concrete evidence of record. *In re Zurko*, supra. *In re Lee*, supra. The Office has not established a *prima facie* case of obviousness with regard to pending claim 27.

### **Claim 30**

Pending claim 30 was provisionally rejected as unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209 in view of Okamoto.

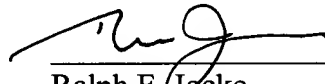
Pending claim 30 depends from claim 13. Appellants have already shown that pending claim 13 is not an obvious variation of claim 1 of application 10/980,209. Okamoto cannot alleviate the previously discussed deficiencies of claim 1 of application 10/980,209 with respect to pending claim 13, because Okamoto also does not teach or suggest Appellants' recited features which are not found therein.

Nor does Okamoto teach or suggest the additionally recited features in claim 30. The Action is silent as to where Okamoto allegedly teaches or suggests the recited features. Nor does Okamoto teach or suggest a computer that is operative to automatically display a visual output through a display device responsive to processing a document with the computer. The Office has not established a *prima facie* case of obviousness with regard to pending claim 30.

## CONCLUSION

Each of Appellants' claims meets the requirements of 35 U.S.C. § 112. The provisional rejections on the grounds of nonstatutory obviousness-type double patenting are without merit. The applied application claims, taken either alone or in combination with applied art, are devoid of any teaching or suggestion for combining features thereof so as to produce the recited invention. Each of the pending claims specifically recites features, relationships, and/or steps that are neither disclosed nor suggested in any applied prior art. For these reasons it is respectfully submitted that all of the pending claims are allowable.

Respectfully submitted,



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## CLAIMS APPENDIX

1. Apparatus comprising:

an automated banking machine, including:

an output device, wherein the output device outputs information, whereby  
a user is enabled to perceive outputs from the output device;

an input device, wherein the input device is operative to receive inputs,  
whereby a user is enabled to provide inputs to the machine;

a transaction function device, wherein the transaction function device is  
selectively operative to carry out a transaction function;

a computer, wherein the computer is in operative connection with the  
output device, the input device and the transaction function device;

software executable in the computer, wherein the software includes a browser, wherein the browser is operative to process HTML documents including instructions therein, and wherein the transaction function device is operative to carry out the transaction function responsive to the browser processing at least one document including at least one instruction adapted to cause the computer to cause operation of the transaction function device.

2. The apparatus according to claim 1 wherein the transaction function device includes a sheet dispenser.
3. The apparatus according to claim 1 wherein the transaction function device includes a card reader.
4. The apparatus according to claim 1 wherein the transaction function device includes a printer.
5. The apparatus according to claim 1 wherein the transaction function device includes a depository.

6. The apparatus according to claim 1 wherein the transaction function device includes a keyboard.
7. The apparatus according to claim 1 wherein the software is operative responsive to an instruction to access at least one HTTP record address, wherein the at least one HTTP record address corresponds to at least one HTTP record including instructions adapted to cause the computer to cause operation of the transaction function device.
8. An Automated Teller Machine (ATM) comprising:
  - a computer;
  - a browser operating in the computer;
  - a transaction function device in operative connection with the computer, wherein the computer is operative to cause the transaction function device to carry out a transaction function responsive to at least one HTML format document that is received by the browser.

9. A method comprising the steps of:
- a) operating a browser in at least one computer in connection with an automated banking machine;
  - b) receiving at least one HTML format document with the browser, wherein the at least one HTML format document includes at least one transaction instruction;
  - c) carrying out at least one transaction function with a transaction function device in the automated banking machine responsive to the at least one HTML format document.
10. The method according to claim 9 wherein the automated banking machine includes an output device in operative connection with the computer, and further comprising the step of:
- d) producing an output through the output device responsive to the at least one HTML format document.
11. A method comprising the steps of:

- a) operating a browser in at least one computer in operative connection with an automated banking machine;
  - b) receiving at least one document with the browser, wherein the document includes at least one transaction instruction embedded therein;
  - c) carrying out at least one transaction function with a transaction function device in the automated banking machine responsive to the at least one document including the at least one transaction instruction.
12. An Automated Teller Machine (ATM) that operates to conduct at least one financial transaction responsive to at least one mark-up language document.
13. An automated banking machine comprising:
- a computer in operative connection with the banking machine;
  - at least one transaction function device in the banking machine adapted to carry out at least a portion of a banking transaction;



wherein the computer is adapted to cause at least one banking transaction to be carried out through operation of the at least one transaction function device responsive to at least one mark up language document.

14. The machine according to claim 13 wherein the computer includes document handling software, and wherein the computer is operative to carry out the at least one banking transaction responsive to the document handling software processing the at least one mark up language document.
15. The automated banking machine according to claim 13 wherein the transaction function device includes a note dispenser, and wherein the at least one banking transaction includes dispensing at least one note from the note dispenser.
16. A method comprising the steps of:
  - a) providing an automated banking machine including at least one transaction function device, wherein the automated banking machine is in operative connection with at least one computer;
  - b) processing at least one mark up language document with the computer;

- c) carrying out at least a portion of a banking transaction with the transaction function device responsive to processing the at least one mark up language document with the computer in step (b).
- 17. The method according to claim 16 wherein the transaction function device includes a note dispenser, and wherein in step (c) the portion of the banking transaction includes dispensing at least one note with the note dispenser.
- 18. The method according to claim 16 wherein the transaction function device includes at least one reader device, and wherein in step (c) the portion of the transaction includes reading indicia with the reading device.
- 19. The method according to claim 18 wherein the reading device includes a card reader, and wherein in step (c) indicia is read from a card.
- 20. The method according to claim 16 wherein the transaction function device includes at least one key, and wherein in step (c) the portion of the banking transaction includes sensing an input through the at least one key.
- 21. The method according to claim 16 wherein the transaction function device includes a depository, and wherein in step (c) the portion of the banking transaction includes receiving a deposit with the depository.

22. The method according to claim 16 wherein in step (a) the banking machine includes at least one output device, and further comprising the step of:
- d) providing at least one output through the output device responsive to processing at least one mark up language document with the computer.
23. The method according to claim 22 wherein the computer includes browser software, and wherein in step (d) the at least one output is provided responsive to the browser software processing the at least one mark up language document.
24. The method according to claim 23 wherein the output device includes a screen and wherein in step (d) the at least one output includes a visual output through the screen.
25. The method according to claim 16 wherein in step (b) at least one HTML document is processed by the computer.
26. The method according to claim 16 wherein the automated banking machine includes an output device, and wherein in step (c) processing the at least one mark up language document is operative to cause the computer to provide an output through the output device and to carry out at least the portion of the banking transaction.

27. The method according to claim 16 wherein the computer is operative to cause the carrying out of the portion of the banking transaction responsive to at least one software applet.
28. The apparatus according to claim 14 wherein the document handling software includes a browser, wherein the computer is adapted to automatically operate at least one transaction function device responsive to the processing of at least one mark up language document with the document handling software.
29. The apparatus according to claim 28 wherein at least one transaction function device includes a currency sheet dispenser, and wherein the banking transaction includes dispensing at least one currency sheet from the currency sheet dispenser.
30. The apparatus according to claim 13 and further including a display device having a display screen, wherein the computer includes document handling software, wherein the computer is operative to automatically display at least one visual output through the display device responsive to processing at least one mark up language document with the computer.

(ix)

## EVIDENCE APPENDIX

### Claim 1 in application 10/980,209

A method comprising:

- a) operating at least one computer in an automated banking machine, wherein the automated banking machine is operative to carry out financial transactions responsive to operating the at least one computer and includes at least one input device adapted to receive identifying inputs usable to identify at least one of users and user financial accounts, and a cash dispenser adapted to dispense cash to users of the machine;
- b) responsive to at least one first condition of the machine that occurs responsive to operation of the machine, operating the at least one computer in the machine to send at least one first message from the machine to at least one first computer remote from the machine, wherein the at least one first message comprises at least one markup language document, wherein the at least one markup language document includes data corresponding to the at least one first condition.

Claim 12 in application 09/233,249

A first automated transaction machine apparatus including:

a first computer of a first type, wherein the first computer includes at least one first output device, wherein the first output device is operative to provide at least one output to users of the first machine, and at least one first input device, wherein the first input device is operative to receive at least one input from users of the machine;

a first transaction function device in operative connection with the first computer, wherein the first transaction function device is operative to carry out a transaction function;

first transaction machine interface software in operative connection with the first computer;

a first instruction document in operative connection with the first computer, wherein the first instruction document includes at least one command instruction;

wherein the first computer is operative responsive to at least one first input to the first input device to cause the first transaction function device to carry out the transaction function, and wherein the first computer is further operative to generate a first output through the first output device responsive to the first input, the first transaction machine interface software and at least one command instruction in the first instruction document.

(x)

**RELATED PROCEEDINGS APPENDIX**

Attached is a copy of a prior Board Decision (dated October 8, 2003; Appeal No. 2003-1651) regarding this application, as identified in section (ii) of this Appeal Brief.

Also attached is a copy of the application 09/193,791 Board Decision (dated March 9, 2005; Appeal No. 2004-1824) and a copy of the application 09/193,662 Board Decision (dated October 25, 2004; Appeal No. 2003-1659).

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

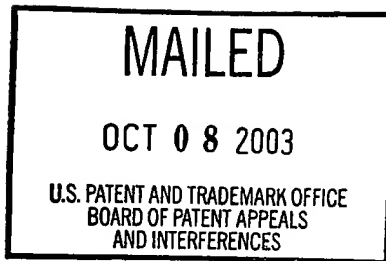
Paper No. 25

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte JAY PAUL DRUMMOND et al.

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Appeal No. 2003-1651  
Application No. 09/193,787<sup>1</sup>

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ON BRIEF

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Before ABRAMS, McQUADE, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection (Paper No. 18, mailed September 16, 2002) of claims 1 to 30, which are all of the claims pending in this application. On page 2 of the reply brief (Paper No. 22, filed April 18, 2003), the appellants noted that (1) they are willing to amend dependent claim 27 to include mutually agreeable language in order to overcome the sole rejection of claim 27 as

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<sup>1</sup> Filed November 17, 1998. According to the appellants, the application claims benefit of provisional Application No. 60/031,956, filed November 27, 1996.



being indefinite under the second paragraph of 35 U.S.C. § 112; and (2) the rejection of claim 27 no longer appears to be an issue. Accordingly, we deem the appeal with respect to claim 27 to be withdrawn and we dismiss the appeal with respect to claim 27. Claims 1 to 26 and 28 to 30 remain on appeal.

We REVERSE.

#### BACKGROUND

The appellants' invention relates to automated banking machines (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The references of record relied upon by the examiner in rejecting the appealed claims are:

McLean	4,337,864	July 6, 1982
McMillan	5,436,435	July 25, 1995
Russell et al. (Russell)	5,905,248	May 18, 1999
Zeanah et al. (Zeanah)	5,933,816 <sup>2</sup>	Aug. 3, 1999

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<sup>2</sup> This patent issued from Application No. 08/908,413, filed August 7, 1997. This patent claims benefit of provisional Application No. 60/029,209, filed October 31, 1996.

Claims 1 to 6, 8-13, 16 and 22 to 26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Zeanah.

Claims 7, 14, 28 and 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Zeanah in view of Russell.

Claim 29 stands rejected under 35 U.S.C. § 103 as being unpatentable over Zeanah in view of Russell and McLean.

Claims 15 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Zeanah in view of McLean.

Claims 18 to 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Zeanah in view of McMillan.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 21, mailed March 11, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 20, filed January 17, 2003) and

reply brief (Paper No. 22, filed April 18, 2003) for the appellants' arguments thereagainst.

### OPINION

The appellants assert (brief, pp. 11-24) that (1) Zeanah is not available as prior art under 35 U.S.C. § 102(e); and (2) the 37 CFR § 1.131 declaration of Jay Paul Drummond (Paper No. 13, filed February 4, 2002) is sufficient to overcome the prior art rejections under appeal. We agree.

The burden of establishing a prima facie case of anticipation resides with the examiner. See In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Likewise, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

It is the examiner's burden to establish that Zeanah is available as prior art under 35 U.S.C. § 102(e)<sup>3</sup> with respect to the claims under appeal. This the examiner has not done.

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<sup>3</sup> 35 U.S.C. § 102(e) provides that a person shall be entitled to a patent unless the invention was described in a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent.

To establish that Zeanah is available as prior art under 35 U.S.C. § 102(e) with respect to the claims under appeal, the examiner must determine that the effective filing date of Zeanah is prior to the effective filing date of the claimed subject matter. Thus, the examiner must determine the effective filing date of Zeanah and the effective filing date of the claimed subject matter.

Zeanah is clearly entitled to at least an effective filing date of August 7, 1997. Zeanah is not entitled to an effective filing date of October 31, 1996 unless the provisional application (Application No. 60/029,209) discloses the claimed invention in the manner required by the first paragraph of 35 U.S.C. § 112.<sup>4</sup> The examiner has not determined that provisional Application No. 60/029,209 discloses the claimed invention in the manner required by the first paragraph of 35 U.S.C. § 112. Accordingly, for purposes of this appeal, the examiner has only determined that Zeanah is entitled to an effective filing date of August 7, 1997.<sup>5</sup>

The appellants claim benefit back to provisional Application No. 60/031,956, filed November 27, 1996. To apply Zeanah as prior art under 35 U.S.C. § 102(e), the

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<sup>4</sup> See 35 U.S.C. § 119(e).

<sup>5</sup> The examiner's position (answer, pp. 14-15) that due to the presumption of validity the patent to Zeanah is presumed to be entitled to the October 31, 1996 filing date of the provisional application is without merit.

examiner must also determine the effective filing date of the claimed subject matter (e.g., is the claimed subject matter entitled to an effective filing date of November 27, 1996). The examiner has not set forth the effective filing date of the claimed subject matter.<sup>6</sup>

Since the examiner has not established that the effective filing date of Zeanah is prior to the effective filing date of the claimed subject matter, the examiner has not established that Zeanah is available as prior art under 35 U.S.C. § 102(e).

In any event, even if Zeanah was available as prior art under 35 U.S.C. § 102(e) with an effective filing date of October 31, 1996, the appellants submit that the Drummond declaration establishes reduction to practice of the subject matter of claims 1-4, 6-19 and 22-27 prior to July 7, 1996, thus overcoming the prior art rejections of claims 1-4, 6-19 and 22-27. The appellants admit (brief, p. 15) that the differences between claims 5, 20, 21 and 28 to 30 and claims 1-4, 6-19 and 22-27 would have been obvious to one of ordinary skill in the art. Thus, the appellants argue that the prior art rejections of claims 5, 20, 21 and 28 to 30 is also overcome by the Drummond declaration.

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<sup>6</sup> The appellants assert that the effective filing date of the claimed subject matter is November 27, 1996.

The examiner's sole expressed objection to accepting the Drummond declaration (answer, pp. 17-18) is that it is not signed by all the joint inventors of the claims under rejection (i.e., claims 1 to 26 and 28 to 30). However, this objection is not a proper basis for refusing to accept the Drummond declaration since that declaration is signed by the inventor of the subject matter of claims 1 to 4, 6 to 19 and 22 to 27). 37 CFR § 1.131 permits such a declaration to be signed by less than all of the inventors.

Since the examiner has not proffered any valid objection as to why the Drummond declaration does not establish a reduction to practice of the subject matter of claims 1-4, 6-19 and 22-27 prior to July 7, 1996, the Drummond declaration must be accepted by us as sufficient to overcome the prior art rejections under appeal.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 6, 8-13, 16 and 22 to 26 under 35 U.S.C. § 102(e) is reversed and the decision of the examiner to reject claims 7, 14, 15, 17 to 21 and 28 to 30 under 35 U.S.C. § 103 is reversed.

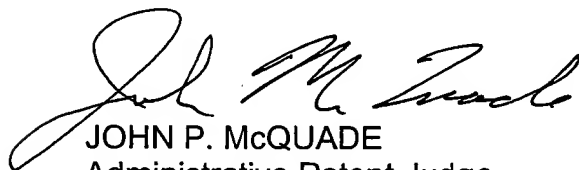
CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 6, 8-13, 16 and 22 to 26 under 35 U.S.C. § 102(e) is reversed and the decision of the examiner to reject claims 7, 14, 15, 17 to 21 and 28 to 30 under 35 U.S.C. § 103 is reversed.

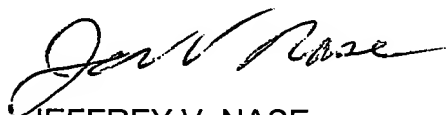
REVERSED



NEAL E. ABRAMS  
Administrative Patent Judge



JOHN P. McQUADE  
Administrative Patent Judge



JEFFREY V. NASE  
Administrative Patent Judge

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Appeal No. 2003-1651  
Application No. 09/193,787

Page 9

RALPH E. JOCKE  
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JVN/jg



The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JAY PAUL DRUMMOND, DALE BLACKSON,  
BOB A. CICHON, JOSEPH C. ESS, MARK A. MOALES,  
DAVID W. WEIS, MARK D. SMITH,  
and JAMES CHURCH

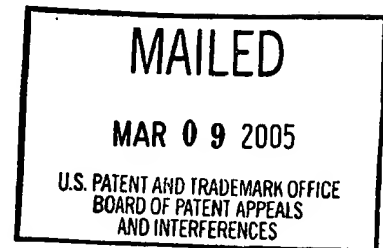
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Appeal No. 2004-1824  
Application No. 09/193,791

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ON BRIEF

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Before OWENS, MACDONALD, and NAPPI, *Administrative Patent Judges*.  
OWENS, *Administrative Patent Judge*.

*DECISION ON APPEAL*

This appeal is from a nonfinal rejection of claims 1-20, which are all of the claims in the application.<sup>1</sup>

*THE INVENTION*

The appellants claim an apparatus comprising an automated transaction machine, and a method for operating the apparatus.

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<sup>1</sup> In an appeal in which claims have been at least twice rejected, the board has jurisdiction as discussed in *Ex parte Lemoine*, 46 USPQ2d 1432 (Bd. Pat. App. & Int. 1995).

Appeal No. 2004-1824  
Application No. 09/193,791

Claim 1, which claims the apparatus, is illustrative:

1. Apparatus comprising:
  - an automated transaction machine including:
    - an output device;
    - a currency sheet dispenser;
    - a computer in operative connection with the output device and the currency sheet dispenser; and
    - software executable in the computer, wherein the software includes a browser, and wherein during operation of the currency sheet dispenser the software is operative to provide an output through the output device responsive to a document accessed by the browser.

#### *THE REFERENCES*

Dialog® File 630: Times Staff and Wire Reports, "Trade-It-Yourself Bank Machines Make a Debut - Securities: Citibank is first to offer full-scale brokerage services at ATM machines. Option comes to California next month", Los Angeles Times Home Edition, Business Section, page 1, pt. D, col. 5, October 6, 1994 (LA Times).

Mark Leon, "TP-monitor vendors spin Web features - NCR, IBM, BEA Systems enhance products to facilitate transactions over Web", Infoworld, July 1, 1996 (Infoworld).

#### *THE REJECTION*

Claims 1-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over LA Times in view of Infoworld.

*OPINION*

We reverse the aforementioned rejection. We need to address only the independent claims, i.e., claims 1, 2, 4, 7 and 13.

*The applied prior art*

LA Times discloses that Citibank offers an automatic teller machine (ATM) that lets users buy and sell stocks, get market values for securities, and trade shares of the bank's money market funds. The ATMs have separate menus for banking and brokerage services, and a screen offers a choice between information or trading. If trading is chosen, the next screen is a full page of disclosure about stock market risks. "Those who just want to check stock prices will pull up a picture of a typewriter keyboard. By touching the screen, they can type in the name of the company or its ticker symbol and get a real-time stock quote or the previous day's mutual fund closing price."

Infoworld discloses that NCR Corp. "is out to turn the Internet into a giant virtual cash register with enhancements to its Top End middleware that will let users deploy point-of-sale applications over the World Wide Web." NCR "delivered a Java client to the Top End transaction processing (TP) monitor, a Web specific version of Top End designed to take advantage of the Internet and bypass weaknesses in standard Internet protocols",

and "has rewritten the Top End client code, which runs on PCs and sits inside automated teller machines and cash registers, as a set of Java class libraries." "Rather than establishing a client-to-server connection using Common Gateway Interface (CGI), the Java client downloads into the Web browser and establishes a direct link to the Top End back-end application." Thus, "[i]nstead of going through the Web server and CGI on the back end, [NCR] lets Java set up a private TCP/IP connection."

*Claim 1*

Claim 1 requires an automatic transaction machine including an output device, a currency sheet dispenser, and software which includes a browser and which, during operation of the currency sheet dispenser, is operative to provide an output through the output device responsive to a document accessed by the browser.

The examiner argues that the Infoworld "browser interface is the interface through which all the ATM banking functions of the NCR ATM machine are performed, such as account access, funds transfer, the dispensing of currency and receipts responsive to the interaction of the user with the web browser interface" (rejection mailed July 15, 2003, paper no. 15, page 4). The disclosures in Infoworld that 1) the client code sits inside the ATM as a set of Java class libraries and runs on PCs, 2) the Java

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client downloads into the Web browser and establishes a direct link to the Top End back-end application, 3) NCR lets Java set up a private TCP/IP connection, 4) NCR's enhancements will let users deploy point-of-sale applications over the World Wide Web, and 5) "[t]he whole idea is to make one or 10,000 machines look as if they are local to your computing resource", indicate that the web browser is in the user's computer, not in the ATM. That is, these disclosures indicate that the client code which runs on PCs is downloaded into the user's web browser to establish a direct link to the Top End back-end application, thereby setting up a private TCP/IP connection that makes the user's computer look as if it is local to the ATM system. The examiner has not explained how Infoworld supports the alternative interpretation argued by the examiner.

Moreover, the examiner has not established that LA Times and Infoworld would have fairly suggested, to one of ordinary skill in the art, a system capable of providing, during operation of a currency sheet dispenser, an output through an output device responsive to a document accessed by the browser. The examiner states that "[t]he examiner takes official notice of the fact that it is notoriously well known in the art of sheet feeders that the documents processed by the controlling web browser

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interface of a particular sheet feeding machine contain instructions for controlling the output devices of the machine, such as dispense instructions for feeding sheets through the output devices of the machine, such an arrangement providing an effective and reliable control system for the output devices of the machine" (rejection mailed July 15, 2003, paper no. 15, pages 4-5). An examiner "may take notice of facts beyond the record which, while not generally notorious, are capable of such instant and unquestionable demonstration as to defy dispute." *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970). The facts of which the examiner has taken official notice, however, do not reasonably appear to be capable of such instant and unquestionable demonstration as to defy dispute. "Assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or reputation of the cited reference [citations omitted]. Allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge." *Ahlert*, 424 F.2d at 1091, 165

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Application No. 09/193,791

USPQ at 420-21. Because the examiner has not provided such support for the examiner's argument, that argument is not well taken.

We therefore conclude that the examiner has not carried the burden of establishing a *prima facie* case of obviousness of the apparatus claimed in the appellants' claim 1. Accordingly, we reverse the rejection of that claim and claim 15 that depends therefrom.

*Claims 2 and 4*

Claims 2 and 4 include the above-discussed limitations in claim 1 which, as discussed above regarding the rejection of that claim, the examiner has not shown to have been fairly suggested to one of ordinary skill in the art by the applied prior art.

Claims 2 and 4 further require that a document accessed by the browser includes instructions for causing the computer to operate the sheet dispenser. The examiner relies upon the above-quoted official notice for that claim requirement (rejection mailed July 15, 2003, paper no. 15, pages 4-5). As discussed above regarding the rejection of claim 1, the reliance upon that official notice is not sufficient for establishing a *prima facie* case of obviousness of the claimed invention.

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For the above reasons we reverse the rejection of claim 2 and its dependent claim 3, and claim 4 and its dependent claims 5 and 6.

*Claims 7 and 13*

Claims 7 and 13 require accessing a document with a browser in an automated transaction machine. As discussed above regarding the rejection of claim 1, the examiner has not established that the applied references would have fairly suggested that claim requirement to one of ordinary skill in the art. Alternatively, if the recited browser is considered to be the browser in the user's computer, the examiner has not established that the user's computer having the browser reasonably can be considered to be an automated transaction machine.

Accordingly, we reverse the rejection of claim 7 and claims 8-12 and 16 that depend directly or indirectly therefrom, and claim 13 and claims 14 and 17-20 that depend directly or indirectly therefrom.



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Application No. 09/193,791

### DECISION

The rejection of claims 1-20 under 35 U.S.C. § 103 over LA Times in view of Infoworld is reversed.

**REVERSED**

Terry J. Owens  
Terry J. Owens  
Administrative Patent Judge

Allen R. MacDonald  
Administrative Patent Judge

BOARD OF PATENT

APPEALS AND

## INTERFERENCES

Robert E. Nappi  
Administrative Patent Judge

TJO/eld

Appeal No. 2004-1824  
Application No. 09/193,791

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Medina, OH 44256

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

MAILED

OCT 25 2004

U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte BRUCE G. RICHARDS, JAY PAUL DRUMMOND, DALE BLACKSON,  
BOB A. CICHON, JOSEPH C. ESS, MARK A. MOALES,  
DAVID W. WEIS, MARK D. SMITH, and JAMES CHURCH

Appeal No. 2003-1659  
Application No. 09/193,662

ON BRIEF

Before JERRY SMITH, SAADAT, and NAPPI, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-37, which constitute all the claims in the application.

The disclosed invention pertains to an Automated Teller Machine (ATM) adapted to operate in response to communication with an ATM host via an HTTP server. The ATM host communicates with the HTTP server through messages having a non-HTTP format,

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Application No. 09/193,662

and the HTTP server communicates with the ATM through HTTP messages.

Representative claim 1 is reproduced as follows:

1. Apparatus comprising:  
an ATM host, wherein the ATM host is operative to send and receive ATM transaction messages; and  
an HTTP server in operative connection with a database, wherein the database includes conversion data, wherein the server includes server software operative responsive to an ATM transaction message sent by the ATM host and the conversion data, to generate at least one data object including transaction data.

The examiner relies on the following references:

Vak et al. (Vak)	5,473,143	Dec. 5, 1995
Anderson et al. (Anderson)	5,706,442	Jan. 6, 1998

Claims 7-10 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Anderson. Claims 1-6 and 11-37 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Anderson in view of Vak.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as

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Application No. 09/193,662

support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon does not support either of the examiner's rejections of the claims on appeal. Accordingly, we reverse.

We consider first the rejection of claims 7-10 as being anticipated by Anderson. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner's rejection of these claims is set forth in the rejection mailed on April 23, 2001. With respect to independent

claim 7, appellants argue that the examiner has failed to specify where Anderson discloses an automated transaction machine.

Appellants also argue that there is no indication that the item identified as the sheet dispenser in Anderson in fact dispenses sheets. Appellants argue that Anderson does not teach the claimed relationship of a server, HTTP messages, non-HTTP transaction messages and conversion data. Finally, appellants argue that Anderson does not teach server software that can operate in the manner claimed [brief, pages 15-17]. Appellants also argue that the portion of Anderson relied on by the examiner as teaching conversion data does not support the examiner's position [reply brief, page 3]. The examiner's answer does not specifically respond to any of these arguments.

We will not sustain the examiner's rejection of claims 7-10 for essentially the reasons argued by appellants in the main brief. Appellants have raised reasonable questions regarding the examiner's findings in support of anticipation. We have reviewed the portions of Anderson cited by the examiner in support of the rejection, and we agree with appellants that the cited portions fail to provide clear support for the examiner's findings. It certainly was not helpful that the examiner completely ignored appellants' arguments made in the main brief. On the record

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Application No. 09/193,662

before us, we agree with appellants that the examiner's rejection on anticipation is not supported by the applied reference.

We now consider the rejection of claims 1-6 and 11-37 under 35 U.S.C. § 103 based on Anderson and Vak. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an

essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 1.192(a)].

The examiner's rejection essentially finds that Anderson teaches the claimed invention except that Anderson does not disclose an ATM host. The examiner cites Vak as teaching a communications network for an ATM or POS system. The examiner finds that it would have been obvious to the artisan to use an ATM in Anderson as taught by Vak.



With respect to independent claim 1, appellants argue that Anderson does not teach or suggest an HTTP server with server software that is responsive to both an ATM transaction message sent by the ATM host and conversion data in a data store or generating an object that includes transaction data. Appellants also argue that Vak does not teach or suggest a system for use with an HTTP server. Appellants argue that it would not have been obvious to modify Anderson with the teachings of Vak to produce the claimed invention. Finally, appellants argue that the factual findings of the rejection do not support a prima facie case of obviousness [brief, pages 20-24].

The examiner simply responds that Vak teaches the claimed ATM host and that an HTTP server would be inherently required to interact via the Internet. The examiner also responds that the claimed conversion data is met by the manipulated financial information of Anderson [answer, pages 3-4].

Appellants respond that there is no evidence of record that Vak teaches use of the Internet or HTTP. Appellants argue that Vak's invention does not contemplate an Internet based system. Appellants note that EFT networks do not require use of the Internet. Finally, appellants argue that Anderson does not teach conversion data associated with server software [reply brief].

We will not sustain the examiner's rejection of claim 1 for essentially the reasons argued by appellants in the briefs. Although the examiner cites certain portions of the applied prior art and suggests that the claimed invention is taught by these cited portions, the examiner does not explicitly read the claimed invention on the prior art and it is not clear to us how the examiner reached his conclusions. There are many recitations in the claims that are not specifically addressed by the examiner. Taking claim 1 as an example, it is not clear to us which element represents the database having conversion data included therein, where within Anderson's system the examiner finds the transaction message, and what is the generated data object in Anderson which corresponds to the claimed data object. While these elements may seem trivial, we are unable to substantiate the examiner's findings on this record. The examiner has also failed to address many of appellants' arguments set forth in the main brief. On this record, we are not persuaded that the examiner's rejection is supported by the applied prior art.

We also note that the examiner's rejection fails to provide a claim by claim analysis of how the applied prior art teaches the claimed invention. Appellants have argued each of the claims on appeal separately, and the examiner has failed to respond to

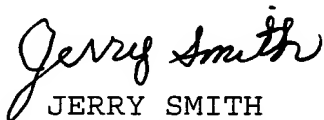
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the specific arguments related to each claim on appeal.

Therefore, the record in this case does not support the rejection of any of the claims made under 35 U.S.C. § 103.

In summary, we have not sustained either of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-37 is reversed.

REVERSED



JERRY SMITH )  
Administrative Patent Judge )



MAHSHID SAADAT )  
Administrative Patent Judge )

) BOARD OF PATENT  
) APPEALS  
) AND  
) INTERFERENCES  
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ROBERT NAPPI )  
Administrative Patent Judge )

JS/sld

Appeal No. 2003-1659  
Application No. 09/193,662

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MEDINA, OH 44256